

1 APPEARANCES: (Continued)

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7 and

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14 P R O C E E D I N G S

15 (REPORTER'S NOTE: The following pretrial
16 conference was held in open court, beginning at 11:05 a.m.)

17 THE COURT: Good morning, everyone.

18 (The attorneys respond, "Good morning, Your
19 Honor.")

20 THE COURT: I'll have you put your appearances
21 on the record for me, please.

22 MR. FARNAN: Good morning, Your Honor.

23 THE COURT: Good morning.

1 MR. FARNAN: Brian Farnan upon behalf of the
2 plaintiff. With me is Jim Muldoon, Neal Slifkin and Laura
3 Smalley, all from Harris Beach, and Michael Sleeve
4 (phonetic) from Greatbatch.

5 THE COURT: Welcome to all of you.

6 MR. MULDOON: Thank you, Your Honor.

7 MR. WHETZEL: Good morning, Your Honor. Bob
8 Whetzel from Richards Layton for the defendants. With me is
9 Ron Cahill, Jason Rawsley, Chad Shandler, Todd Coomes, and
10 our technologist, Daniel White.

11 THE COURT: Welcome to all of you as well. Have
12 a seat.

13 So we are here for the pretrial conference for
14 the jury trial scheduled to begin on January 11th. We've
15 got quite a lot to cover in our time together today. Let me
16 tell you the order in which I plan to go through things.

17 I first want to hear argument on AVX's motion
18 for reargument or clarification with respect to the '627
19 patent, and the related request for supplemental claim
20 construction of Greatbatch and essentially talk about
21 whether or not the '627 patent infringement is an issue for
22 the jury or not. So we'll start with the discussion of all
23 of those issues which I view as related.

24 After that, we'll hear brief argument if the
25 parties wish to be heard on Greatbatch's motion for sanctions

1 which is still outstanding.

2 Then we'll move on to the motions in limine, and
3 I'll rule on most of them without argument, but I believe I
4 will need argument on at least one of them.

5 Then we'll discuss numerous other issues that
6 the parties raised in the pretrial order. We'll talk about
7 the mechanics of the trial.

8 And I'll give you an opportunity after all of
9 that to raise any other issues that you may have that we
10 haven't otherwise gotten to.

11 But before I dive into all of that, I will give
12 you a chance now to ask me, if you have any questions, or if
13 there is anything you want me to know before we dive into
14 the agenda I have laid out. So first from the plaintiffs.

15 MR. MULDOON: No, Your Honor.

16 THE COURT: Okay. And from the defendants?

17 MR. WHETZEL: No, Your Honor. We're prepared to
18 proceed.

19 THE COURT: Okay. Then let's start with the
20 whole issue of clarification and claim construction related
21 to the '627 patent. I'll hear from the defendants first.

22 MR. WHETZEL: Yes, Your Honor. And, first, as
23 to the clarification request, as the Court is aware, Your
24 Honor construed the "asymmetry" and related term "symmetry"
25 in the claim construction order that was issued a few weeks

1 ago. We ask the Court construe the term "non-ground lead
2 passageways" as the Court used the order in light of an
3 apparent dispute as to what that term means.

4 We ask the Court simply to construe that term
5 or to define that term in the language of the claims
6 specifically to mean "passageways for terminal pins" or in
7 the specific language of claim 11 "first passageways."

8 Greatbatch, by contrast, is proposing that claim
9 be defined very broadly. We think indefinitely, and by
10 reference to structures that are not claimed in, described
11 in or really even part of the '627 claims or invention.

12 So the Court determined that "symmetrical" is
13 to be defined with reference to ground lead passageway and
14 non-ground lead passageways. In so doing, the Court
15 construed and looked at the intrinsic evidence in a
16 particular specification and embodiments that illustrate the
17 symmetrical and asymmetrical devices.

18 The term of interest here is "feedthrough filter
19 capacitor." In the patent that is consistently defined as
20 including first and second sets of plates, a first
21 passageway, and a second passageway.

22 From that, Your Honor, we conclude that the
23 asymmetrical or symmetrical relationship has to be between
24 those elements. There is nothing else claimed. There is
25 nothing else disclosed. There is nothing else even hinted at.

1 THE COURT: If I ask it in this way, what is
2 your response? Is the symmetry to be measured with respect
3 to the feedthrough filter capacitor as a whole?

4 MR. WHETZEL: I think it is to be defined with
5 respect to the feedthrough filter capacitor as it is
6 described and claimed in the patent.

7 THE COURT: And is that as a whole?

8 MR. WHETZEL: As a whole, Your Honor, it's
9 described and claimed in the patent with reference to plates
10 and passageways.

11 THE COURT: Is there a factual dispute as to
12 what the feedthrough filter capacitor is as a whole?

13 MR. WHETZEL: I don't believe so, Your Honor. I
14 believe Greatbatch is in agreement that the structure of
15 the accused products is known. Their expert analysis, which
16 we've put forward in our motion, illustrates very clearly
17 the first and second passageways. They don't point to this
18 other hole in the feedthrough filter capacitor. And I
19 think the claim and the specification make clear what the
20 patentee meant and what the patent covers in terms of what
21 the feedthrough filter capacitor is. I think that is a
22 question of law and a question of fact.

23 THE COURT: I have your motion in front of me,
24 and I want to talk to you about the figure you have at page
25 5. So you may want to grab it.

1 MR. WHETZEL: Yes, Your Honor.

2 THE COURT: If I look at the top figure on page
3 5, it's pointing out first passageways. Do you see what I'm
4 talking about?

5 MR. WHETZEL: If Your Honor gives me one second?

6 THE COURT: Sure. Take your time.

7 (Pause.)

8 MR. WHETZEL: I grabbed the wrong notebook. I
9 apologize.

10 THE COURT: I've got plenty of paper here myself.

11 MR. WHETZEL: Yes, Your Honor.

12 THE COURT: All right. So towards the bottom
13 of that top figure, there is a solid line that goes around
14 and encompasses all of what you have labeled here as first
15 passageways as well as that hole to the left of the figure
16 that is not labeled. Do you understand which line I'm
17 talking about?

18 MR. WHETZEL: I do, Your Honor. The dashed line.

19 THE COURT: Not the dashed line. I'm talking
20 about the solid line.

21 MR. WHETZEL: Yes, Your Honor.

22 THE COURT: But then I did want to refer you to
23 the dashed line which is interior to the solid line. Do you
24 see what I'm talking about?

25 MR. WHETZEL: I do, Your Honor.

1 THE COURT: The dashed line does not include
2 within it the circle that is unlabeled to the left. Do you
3 see that?

4 MR. WHETZEL: Um-hmm.

5 THE COURT: And that circle to the left as I
6 understand it, that is the hole for the RF antenna. Correct?

7 MR. WHETZEL: That's correct, Your Honor.

8 THE COURT: All right. So my question is, the
9 feedthrough filter capacitor has a hole, is it what is
10 encompassed by the solid line or is it what is encompassed
11 by the dashed line or is it something else?

12 MR. WHETZEL: Your Honor, first I'd point the
13 Court to the claim in the specification and in particular
14 the element of claim 11 that talks about feedthrough filter
15 capacitor and the elements that are described there which
16 again would be plates, the first passageways and the second
17 passageways.

18 With specific reference to this figure, that
19 most certainly is not everything that is included within
20 the solid line. The patent also makes reference to a common
21 base structure or to a common ceramic structure that can
22 contain multiple feedthrough filter capacitors and other
23 things.

24 So it's defendants' position that the structure
25 shown in the solid line is more than the feedthrough filter

1 capacitor. And, of course, the Court has already construed
2 "feedthrough filter capacitor" to mean "a capacitor that is
3 designed for use in combination with electrical connectors
4 and filters high frequency electrical signals."

5 I don't think there is any dispute, and in
6 Greatbatch's expert analysis it is conceded that this hole
7 for the RF pin is not connected to electrode plates and is
8 not filtered.

9 THE COURT: So I take from all of that that in
10 the defendants' view, the solid line area is more than the
11 whole feedthrough filter capacitor of the claim; correct?

12 MR. WHETZEL: As claimed. Yes, Your Honor.

13 THE COURT: Now, is it further the defendants'
14 view that what is within the dashed lines is the hole of the
15 feedthrough filter capacitor?

16 MR. WHETZEL: Your Honor, I will answer by
17 saying everything within the dashed line is part of the
18 feedthrough filter capacitor. As claimed, the feedthrough
19 filter capacitor more specifically is the plates and the
20 passageways and the asymmetry relationship that we're
21 looking for is in specific the relationship between the
22 second passageway and the first passageways.

23 THE COURT: All right. You may go on.

24 MR. WHETZEL: I think Your Honor has largely,
25 through the Court's questioning, addressed the other points

1 that I wanted to mention.

2 As we have submitted in our papers, we believe
3 this issue is dispositive of claim 11, at least under the
4 Court's claim construction.

5 We don't believe that Greatbatch's construction
6 could possibly be correct. You can't apply non-ground
7 lead passageways to a structure or feature and element that
8 is not claimed and disclosed in or even discussed in the
9 patent. That would render the claim invalid under various
10 Section 112 theories and that is not an appropriate
11 construction.

12 On that basis, we submit that the Court should
13 enter summary judgment of noninfringement for that. These
14 issues were raised in the summary judgment papers that were
15 presented in court. And under settled authority, the Court
16 has the authority to enter summary judgment in this case for
17 the nonmovant.

18 THE COURT: So if I were, alternatively to your
19 approach, to adopt the plaintiff's approach and I guess
20 reconstrue or modify our construction, under that view,
21 would I grant judgment to them and take the issue away from
22 the jury or would there be a jury issue in your view?

23 MR. WHETZEL: Your Honor, that is, the former is
24 the position we have taken in our papers. If the Court is
25 inclined to apply a mirror-image-based claim construction to

1 the structures as shown and it is going to include this
2 hole for the RF pin, I can't fairly argue that the structure
3 would be symmetric under that application.

4 THE COURT: So on the defendants' view, regardless
5 of which way I come out, the question of infringement of the
6 '627 shouldn't be placed before the jury.

7 MR. WHETZEL: Yes, Your Honor.

8 THE COURT: Now, I don't mean to fight with you
9 on that but let me make sure I understand. Why is there not
10 alternatively a genuine dispute of fact as to whether the
11 hole of the feedthrough filter capacitor is the solid line
12 or the dashed line or perhaps something else?

13 MR. WHETZEL: We view that as an issue of claim
14 scope and claim construction, Your Honor. I think it is an
15 issue of law. I think it goes to the scope of the claim,
16 what is the feedthrough filter capacitor, what is the
17 passageway and, most importantly for this purpose, what
18 features do we look to to find the asymmetry relationship.

19 THE COURT: So assume I'm persuaded that it is a
20 question of law, the whole infringement question one way or
21 the other. What impact does that have on the jury trial?
22 Do you want to go forward on your invalidity defenses with
23 respect to the '627 or does that depend on which way I come
24 out?

25 MR. WHETZEL: Well, certainly, Your Honor, if

1 the Court finds claim 12 to be infringed, we need to proceed
2 on the invalidity defenses. If the Court finds claim 12 to
3 be not infringed, for the most part the invalidity defenses
4 are raised as affirmative defenses and therefore would not
5 be presented at this time.

6 There is, as the Court may recall, a
7 counterclaim for invalidity and equitable conduct with
8 respect to the inventorship issue as an affirmative defense,
9 although there is a debate about that apparently as we heard
10 this morning, and also with respect to the inequitable
11 conduct issue which would only be for a bench trial.

12 I would think if the Court granted summary
13 judgment of noninfringement, with an appropriate stipulation
14 or if there is a dispute and order, that the remaining
15 inventorship and inequitable conduct issue could likely be
16 postured for presentation in a subsequent bench trial at
17 whatever point that may be scheduled.

18 THE COURT: All right. And if and you need to
19 confer on this, that is fine. I don't mean to pin you down,
20 no puns intended. In terms of the request for the number of
21 hours for this trial, if I'm ultimately persuaded that the
22 '627 infringement at least is not for the jury, does that
23 have any impact on your request for I think it was 30 hours?

24 MR. WHETZEL: Your Honor, that depends on,
25 without trying to pin the Court down, which way the Court

1 goes on that issue. If the invalidity issues remain for
2 trial to the jury, I don't think that materially affects
3 the length of the trial in this case.

4 If the infringement issue is decided in AVX
5 favor and the invalidity affirmative defenses do not proceed
6 to the jury trial, that would knock a substantial portion of
7 time off of the trial request but without consulting with my
8 co-counsel, I'd prefer not to be pinned down on a specific
9 number, but it would shorten the amount of time.

10 THE COURT: Okay. Thank you. Is there anything
11 else before I hear from plaintiff?

12 MR. WHETZEL: Not on this issue, Your Honor.

13 THE COURT: All right. Let me hear from
14 plaintiff then.

15 MR. SLIFKIN: Thank you, Your Honor.

16 THE COURT: Good morning.

17 MR. SLIFKIN: First, I'd like to say we're at a
18 fairly substantial disadvantage here because they filed a
19 brief on the issue. Our brief is not yet due, won't be due
20 until January 4th, I believe. Although we have given some
21 of our arguments in the pretrial order, we haven't filed a
22 formal response to their motion for reconsideration.

23 THE COURT: Well, what would you have me do then?

24 MR. SLIFKIN: We would file our brief, according
25 to the Court's procedures, and they would file a reply. I

1 assume they would do an expedited one and not take a full
2 amount of time for the reply.

3 THE COURT: Have you asked to modify the
4 briefing schedule?

5 MR. SLIFKIN: No, Your Honor. We believe that
6 our brief is due January 4th, and we don't believe any
7 modification is necessary. We would file it on January 4th.
8 And they would need the modification or they would just do
9 the reply in a day or two.

10 So we have not fully briefed this issue. I am
11 prepared to talk about it, but I'd just like to state we are
12 at a disadvantage because they have submitted a full brief.

13 THE COURT: It is one thing to say you are at a
14 disadvantage, it is another to say you think it would be
15 somehow a violation of your rights or truly unfair for me
16 to rule on an issue for a trial that is five weeks away.

17 MR. SLIFKIN: I think, Your Honor, they filed
18 the full brief and we have not. So, yes, we have not had
19 the opportunity to brief the issue.

20 I am prepared to respond to some of their
21 arguments, but I do think if the Court is inclined to rule
22 against us, we have been prejudiced by the fact that they
23 filed a motion under the Court's procedures and have not
24 allowed enough time for us to do our opposition papers
25 before this appearance at the court.

1 THE COURT: All right. Let's see how far we can
2 get. Go ahead.

3 MR. SLIFKIN: Sure. So in addition to the issue
4 on the briefing schedule, we just think it's too late to be
5 raising this issue, Your Honor. They could have moved when
6 they moved for summary judgment on the indefiniteness issue.
7 They could have at the same time said, in the alternative,
8 here is what we believe it means. Here is the construction
9 we propose.

10 They didn't. They made a strategic decision to
11 live or die by the motion on indefiniteness. The Court
12 found the claim to be indefinite and offered a construction.

13 Now, after they don't like the construction,
14 they're making yet another motion and not a motion for a
15 construction but a motion to construe the construction.
16 They want you to define what certain words in your examples,
17 in your construction mean.

18 The construction itself is very simple.
19 "Asymmetry" means "not symmetrical." Then there are examples.
20 And those examples we believe accurately reflect the meaning
21 and the understanding of the construction. It's simple, it's
22 easy to understand, and it's correct.

23 What they want to do here, Your Honor, is
24 similar to their argument on the pad. They want to split
25 the capacitor into parts. They want to say, oh, but this

1 capacitor has certain parts. And we want you, Your Honor,
2 to look at only certain parts of those, the capacitor. I
3 would like to direct Your Honor's attention to the patent
4 itself.

5 (Elmo settings adjusted.)

6 MR. SLIFKIN: At column 7, line, starting line
7 26 or so. It refers to the feedthrough filter capacitor as
8 Item No. 40.

9 If you go to the drawings, for example, Figure
10 5, you can see 40 is the block of ceramic that now they what
11 they want to say is, oh, wait a minute, capacitor is
12 something else. It's not 40, it is something inside of 40
13 that is part of the capacitor.

14 The patent is very clear and consistent that the
15 entire block of ceramic is the capacitor. I don't think
16 there is any real dispute over that. It's a monolithic
17 capacitor, just like it was a monolithic braze.

18 THE COURT: So looking at the figure I discussed
19 with Mr. Whetzel, how does what you just said translate to
20 that figure?

21 MR. SLIFKIN: Your Honor, I don't have that figure.

22 THE COURT: Mr. Whetzel, do you happen to have
23 an extra copy? And if not ...

24 MR. WHETZEL: I'm certainly happy to share mine,
25 Your Honor.

1 THE COURT: Thank you. We're at page 5 of their
2 motion, and there is the topmost figure. Do you see that?

3 MR. SLIFKIN: Sure. And that figure
4 corresponds, the black line in that figure on the outermost
5 perimeter corresponds exactly to what is shown in Figure 5
6 and other figures.

7 THE COURT: Now, I can tell you have a color
8 copy. Unfortunately, I brought a black-and-white copy.

9 How would you -- by black line, I was focused in
10 my questioning before on the bottom part of that top figure
11 which has a rectangular solid line which looks like it might
12 be black and then has a dashed line inside of it. Are we
13 talking about the same thing?

14 MR. SLIFKIN: We are, Your Honor. The solid
15 line that is around the outer perimeter of the device is the
16 top view of what is shown right there. There may be -- I
17 don't see other views in the patent itself, but if you --
18 that's a perspective view, Your Honor, right there, 5. And
19 what they have is a top view. But we're talking about the
20 same thing. Item 40.

21 THE COURT: So that solid rectangular line at
22 the bottom of the top figure that encompasses not just the
23 dashed line but also the RF antenna hole to the left, that
24 is in the plaintiff's view the entirety of the feedthrough
25 filter capacitor of the claims; correct?

1 MR. SLIFKIN: Yes, Your Honor. And that is
2 consistent with the patent that describes it as monolithic.

3 THE COURT: Now, in the plaintiff's view, is
4 there an actual dispute on that point?

5 MR. SLIFKIN: As to what is the capacitor?

6 THE COURT: What the hole of the feedthrough
7 filter capacitor is.

8 MR. SLIFKIN: In our view, it is very clear from
9 the patent itself that the capacitor is the solid block, the
10 monolithic block or, as the patent said, monolithic ceramic
11 capacitor.

12 That upper part in Figure 5 there, if I may
13 approach the screen?

14 THE COURT: Sure.

15 MR. SLIFKIN: This block on top here is the
16 capacitor. It's ceramic. It's monolithic. It's Item No.
17 40 in the drawing and consistently in all the other figures
18 as well.

19 THE COURT: So is there sufficient evidence
20 in the record from which a reasonable fact-finder could
21 disagree with you and find that, instead, the hole of the
22 feedthrough filter capacitor does not include the RF antenna
23 hole?

24 MR. SLIFKIN: In our view, Your Honor, it's
25 very clear that the entire block is the capacitor. If your

1 construction remains consistent, there is no question of
2 fact of infringement. And I think Mr. Whetzel may have
3 conceded that in the Court's construction. I think it was
4 something about he could not argue that the RF pin was part
5 of that.

6 Certainly, the RF pin is a non-ground lead
7 passageway. In your construction, Your Honor, there are two
8 types of passageways, ground lead and non-ground lead.
9 There is no dispute that the RF pin -- at least I believe no
10 dispute that the RF pin passes through a non-ground lead
11 passageway.

12 So with that construction, and finding that the
13 capacitor is the solid block of ceramic noted by the patent
14 as Item 40, I don't believe there is a dispute of fact as to
15 infringement.

16 THE COURT: So in your view, regardless of which
17 way I come out on this, the '627 infringement issue should
18 not be before the jury?

19 MR. SLIFKIN: Well, Your Honor, certainly, if
20 you find in our favor on the construction, I believe that is
21 the case.

22 If you find that the construction -- I suppose
23 it might depend on how you end up construing your
24 construction is what they're asking for. What do you mean
25 by -- they're asking what do you mean by non-ground lead

1 passageways?

2 So it may depend on what construction, new
3 construction you come up with. I'd have to see it.

4 Yes, Your Honor. There still might be a
5 question of fact as to if we're looking at the plates, and
6 that is the dashed line in the figure in AVX's brief, if
7 we're looking at the plates, the plates are asymmetrical as
8 well.

9 So the plate on the -- the dashed line on the
10 right-hand side is strictly vertical, if you can see what
11 I'm referring to. On the left-hand side. The dashed line
12 has a little jog on it. So if you fold it, the capacitor,
13 in half, the two lines would not match up. They would be
14 asymmetrical.

15 THE COURT: You referenced the "non-ground"
16 language in the patent. Isn't that exemplary or is that the
17 full scope of the patent?

18 MR. SLIFKIN: Well, I'm not sure I understand
19 your question, Your Honor.

20 THE COURT: Well, just a moment ago, when you
21 were talking about the non-ground passageway. Is it your
22 understanding that the scope of the patent claims is
23 exhausted by that or is it just an example, an embodiment?

24 MR. SLIFKIN: Well, there are two types of
25 passageways in describing the patent: ground passageways

1 and non-ground passageways.

2 So with the construction Your Honor has found,
3 certainly the construction covers all passageways described
4 in the patent, non-ground and ground passageways.

5 THE COURT: All right.

6 MR. SLIFKIN: Unless you have any other
7 questions, that is all I have on the issue.

8 THE COURT: Well, I guess just to try to
9 understand your position. I take it you are not prepared to
10 say today, as I heard from Mr. Whetzel. If I understand him
11 correctly, he views infringement of the '627 as not a jury
12 issue no matter what I do. That is not plaintiff's position;
13 correct?

14 MR. SLIFKIN: That is correct, Your Honor.
15 If you change the construction, we still believe that
16 potentially the ground plate issue or the electrode plate
17 issue renders the AVX device asymmetrical. Again, it would
18 depend on how you construed the language, but there still
19 may be an issue of fact as to whether or not, under the new
20 construction, there is symmetry for the electrode plates.

21 THE COURT: If we were to agree with you, though,
22 there is a way in which you suggested this becomes a question
23 of law and you get summary judgment on infringement; correct?

24 MR. SLIFKIN: Yes, Your Honor. If your
25 construction remains intact, I don't think there is any real

1 dispute that there are an unequal number of pins on one
2 side of their products from the other in the two products at
3 issue.

4 THE COURT: And I recognize we're going to
5 multiple levels of contingency here, but do you have any
6 initial thoughts on what impact there might be on the trial
7 depending on whether we take the infringement of the '627
8 issue away from the jury?

9 MR. SLIFKIN: Certainly, the trial would be
10 shorter. We wouldn't need to take that issue to the jury.
11 So other than timing, I don't know that there is much of an
12 impact, Your Honor.

13 THE COURT: Is there anything else?

14 MR. SLIFKIN: No, Your Honor.

15 THE COURT: All right. Thank you. Mr. Whetzel,
16 you can come on back.

17 MR. WHETZEL: Very briefly, Your Honor.

18 I'd like to take the Court back to first the
19 language of claim 11 where the feedthrough filter capacitor
20 is described as having first and second sets of electrode
21 plates, the first passageway and a second passageway, and
22 the language of claim 11 which says the assembly of claim 11
23 wherein the feedthrough filter capacitor is asymmetrical.

24 Claim 12 incorporates claim 11 and incorporates
25 that description of feedthrough filter capacitor and the

1 Court can search the patent specification in its entirety
2 and that is the only description of feedthrough filter
3 capacitor that you will find.

4 Mr. Slifkin made reference to Figure 40 and
5 showed a drawing. I would point the Court to the textual
6 discussion in the specification that describes Figure 40 and
7 it's at column 6 near the bottom third of the column.

8 THE COURT: Is it in fact Figure 40 or is it
9 Item 40?

10 MR. WHETZEL: Item 40. I'm sorry, Your Honor.
11 Item 40, Figure -- it shows up in Figure 5 and perhaps in
12 other figures.

13 THE COURT: Thank you. The record is complex
14 enough for me.

15 MR. WHETZEL: I apologize, Your Honor.

16 And in that discussion of the specification,
17 again consistent with the claim, the specification says that
18 the feedthrough filter capacitor has first and second sets
19 of electrode plates, a first passageway and a second
20 passageway.

21 Now, this hole for an RF pin is indisputably
22 not filtered, not connected to plates, not discussed or
23 disclosed anywhere in the claims or specification of the
24 patent and has nothing whatsoever to do with the function
25 of the claimed invention which is an internally grounded

1 feedthrough filter capacitor.

2 Now, there was a brief reference I heard to
3 perhaps the electrode plates themselves being asymmetrical.

4 Well, first, that is not the Court's claim
5 construction. We're simply asking the Court to clarify,
6 with all respect to the Court, what the term non-ground lead
7 passageways meant in the construction. And we submit that
8 within the scope of the claims and the specification that
9 can only mean first passageways. That's the only structure
10 that is disclosed.

11 And I would also point the Court to the
12 specification at column 9, starting at line 9, with the
13 symmetrical relationship is described. And it says,
14 "wherein the conductive terminal pins are symmetrically
15 positioned about a central ground pin."

16 We think it is very clear as a matter of law,
17 Your Honor, that the symmetry or asymmetry relationship
18 as defined in the patent and construed by the Court is a
19 relationship between the second passageway and the first
20 passageways. And I don't think anyone can look at the
21 structure of accused devices and fairly argue the first and
22 second passageways in those devices don't have the mirror
23 plane relationship that establishes symmetry. Therefore,
24 claim 12 cannot be infringed.

25 THE COURT: It's been pointed out to me that

1 these are comprising claims. Obviously, claim 11 expressly
2 is and claim 12 which depends on it would also be a
3 comprising claim.

4 Doesn't that lead to the conclusion that other
5 elements such as the RF pin could be included?

6 MR. WHETZEL: Your Honor, other elements could
7 be included in the overall device. But when we're looking
8 to find what the symmetry relationship is, I think we need
9 to look at more specifically the actual structure that is
10 claimed and the definition that is given to feedthrough
11 filter capacitor in the claim and with reference to the
12 specification and embodiments.

13 I could do a lot of things to the feedthrough
14 filter capacitor. I could add a resistor to it. I could
15 drill a hole in it. I could do any number of things to it.
16 But that doesn't render it or affect symmetry or asymmetry
17 within the parlance of the '627 patent.

18 THE COURT: And in your view, all of that,
19 regardless of whether you are right or wrong, is an issue I
20 should view as claim scope and resolve as a matter of law?

21 MR. WHETZEL: Yes, Your Honor.

22 THE COURT: So I am faced with a choice of
23 either a last minute construction or asking the jury to
24 resolve something that you think is a question of law.

25 MR. WHETZEL: I'm afraid that is a position

1 we're in, Your Honor. The asymmetry issue and the
2 indefiniteness came up when it came up, and we had the
3 benefit of the Court's construction now for a couple of
4 weeks now and we have moved on that as quickly as we can.

5 Fortunately, I don't think it's a particularly
6 difficult issue as compared to many of the other issues we
7 have grappled with in this case.

8 THE COURT: Do you have anything to say about
9 the plaintiff's at least implicit request that I refrain
10 from ruling today until we finish the briefing at least in
11 the event that I'm not prepared to rule for them?

12 MR. WHETZEL: Your Honor, we're on the eve of
13 trial. We're moving as quickly as we can. I guess the
14 only position that I would say is in a pretrial stipulation,
15 Greatbatch agrees that the design of the accused products is
16 known. They point simply to the RF hole as compared to the
17 first and second passageways. They state in the pretrial
18 that evaluating symmetry is not so technical if the Court
19 requires expert testimony to resolve the issue. They asked
20 the Court to grant summary judgment in their favor on that
21 issue. They addressed the issue.

22 If they want to put in additional papers, I
23 don't think it's going to meaningfully change the analysis
24 the Court has to go through or really add anything to what
25 the parties have presented this morning.

1 THE COURT: All right. Thank you. Mr. Slifkin,
2 is there anything you want to add?

3 MR. SLIFKIN: Yes, Your Honor. With all due
4 respect to Mr. Whetzel, we would like an opportunity to
5 brief our side of the story. It would be somewhat unfair
6 for the Court to rule against us when they filed their
7 opening brief and we haven't.

8 If the Court is going to look at the
9 construction, take another look at the construction, we may
10 have alternative constructions that we believe are better
11 than the ones they have proposed, including the ones that I
12 had referenced, and that is the electrode plates are part
13 of that capacitor. We would like the opportunity to fully
14 brief that, if you are inclined to rule against us.

15 It is somewhat unfair to say here is their view
16 of how you should have construed your construction or what
17 your construction means and not allow us to look at that
18 construction and say we think the Court is correct but, in
19 the alternative, here is a different view of that construction.

20 And, again, we do think the Court got it right.
21 It's simple. It's as one of ordinary skill in the art would
22 have construed that language. "Asymmetrical" means "not
23 symmetrical," and then there are examples that are entirely
24 consistent with the language of the patent.

25 And, Your Honor, as I think you recognize

1 from one of the questions you asked, the claim language is
2 comprising. The capacitor, the block of ceramic includes
3 some parts. Some of those parts are the electrode plates,
4 but ultimately it is a monolithic ceramic capacitor, Item
5 No. 40 in the patent.

6 THE COURT: Okay.

7 MR. SLIFKIN: Thank you.

8 THE COURT: Thank you. I'm going to take all
9 of this that we have discussed under advisement. I may well
10 have more to say about it before we leave today, but I have
11 nothing more to say about it right at this moment, and we
12 have many other things to cover.

13 So let's move on next to Greatbatch's motion for
14 sanctions. We'll hear brief argument on that.

15 MR. MULDOON: Your Honor, there was the issue of
16 the "ground lead conductively coupled to the ferrule" that I
17 thought you had in that.

18 THE COURT: I think I misled you unintentionally
19 to suggest that that would be the next item. I know that
20 is your request for supplemental construction. We'll get to
21 that if we have time. But I did want to move on to motion
22 for sanctions at this point.

23 MR. SLIFKIN: Thank you, Your Honor. This one
24 is mine as well.

25 One thing I would like to point out is

1 Mr. Scalise is here. I may be talking about some attorney
2 eyes' only information regarding the construction of their
3 capacitor. I leave it up to my ...

4 THE COURT: Well, let's do this. I have
5 carefully read the briefs. I don't think you need to get
6 into that level of detail. Just hit on the highlights
7 without getting into the attorney eyes' only information
8 as an initial matter.

9 MR. SLIFKIN: I'm going to have to talk about
10 the size of a certain part inside the product, and I'll
11 leave it up to Mr. Cahill and Mr. Whetzel.

12 MR. CAHILL: The size we think is not attorney
13 eyes' only.

14 MR. SLIFKIN: Great.

15 THE COURT: Okay. Fine.

16 MR. SLIFKIN: So from the information that we
17 have -- oh. And, Your Honor, we have a timeline that I
18 would like to put up on the screen and I have given opposing
19 counsel a copy of it.

20 I have copies for the Court.

21 THE COURT: Okay.

22 (Documents passed forward.)

23 MR. SLIFKIN: Your Honor, from the information
24 we have, and it is somewhat inconsistent and unclear to us,
25 there was a problem with the pin washers discovered in

1 November of 2011 when the switch to palladium pins was made.

2 In the words of Mr. Rios, the solder was free
3 flowing to the gold.

4 I think given the Court's ruling on summary
5 judgment on the subset of the Ingenio parts, I think we now
6 understand that to mean the free flowing is an infringement;
7 when the solder touches the gold, it is an infringement. So
8 the problem of this free flowing solder into the gold was
9 recognized.

10 And then from the information we have, the newly
11 produced documents that came out well after the close of
12 discovery, we know that the washer size was switched in the
13 production models to production units to 14 thousandths.
14 That was the fix that Mr. Rios referred to as though he was
15 unclear on the timing of the fix. So the issue of the
16 washer size, although it seems like it is an insignificant
17 part, could not be more critical to your case.

18 THE COURT: Well, hasn't your expert indicated
19 it is pretty insignificant and potentially irrelevant?

20 MR. SLIFKIN: No, Your Honor. If you look at
21 the language quoted in, they quote in their brief, he says
22 it directly affects the likelihood of infringement. I don't
23 know how much more important it can be than a change that
24 affects the likelihood of infringement.

25 THE COURT: They say there are essentially five

1 documents at issue. Is that correct?

2 MR. SLIFKIN: No, Your Honor. We don't believe
3 so. We believe that this reveals the fact that they have
4 not produced other documents as well. In fact, we know that
5 there is a particular document that was modified, the one
6 with the shadow box, with the cut and paste on it. We know
7 there is an earlier version that didn't have the cut and
8 paste on it. We have never seen that document. So they
9 have pasted over the washer size document and never gave us
10 the original. So we're faced with a situation where the
11 testimony was confusing. Mr. Rios testified both ways.

12 THE COURT: Is it true that English is his
13 second language?

14 MR. SLIFKIN: Your Honor, I don't -- I did not
15 depose Mr. Rios. I don't doubt that is the case. He seems
16 to be fairly articulate to me. He clearly said that the
17 solder was free flowing into the gold.

18 This isn't a, this isn't a really complicated
19 issue with using large words. It is simple English terms,
20 washer size, and solder, and gold. Clearly, he knows what
21 those are. He is an engineer in the field, dealing with
22 primarily an English-speaking employer on these topics. So
23 I don't think that that is an issue.

24 If you look at the questions that Ms. Smalley
25 asked of him, clearly Ms. Smalley was under the impression

1 that production units had 16 thousandths washers. Mr. Rios
2 agreed. And then later on questioning by Mr. Hall, I believe
3 it was, changed his story to now it's 14 thousandths. So we
4 were left with the impression.

5 Oh. And Ms. Smalley was asking about a document
6 reflecting experimentation. This is an experiment to see how
7 should we, what should we do with this washer size to solve
8 our infringement problem, and the production documents were
9 never given to us.

10 What I mean by production documents, documents to
11 produce the part in question were never given to us until they
12 needed to rely on them to defend against summary judgment.

13 So we didn't have the ability to test the
14 witnesses using the documents on the washer size, the change
15 in washer size because we didn't have them.

16 THE COURT: Why would they conceal evidence that
17 is helpful to them?

18 MR. SLIFKIN: Well, if you look at the timeline,
19 Your Honor, you will see that on December 3rd, 2013, it's the
20 first page of our timeline, we sent them a draft, amended
21 complaint, that puts the '715 patent at issue. Sixteen days
22 later, the bottom right-hand box, they start checking into
23 making the washer size smaller. It seems to me that they
24 desperately didn't want us to know that now that we've said
25 we're going to see you under '715 patent, they start looking

1 at, oh, maybe we should make it 14 thousandths or 15
2 thousandths. Well, clearly they're testing 16 days after we
3 sent them the draft complaint.

4 THE COURT: Why wouldn't they want you to know?

5 MR. SLIFKIN: Because it begs the question what
6 were you doing before you changed the washer size?

7 THE COURT: Are you suggesting they want to lull
8 you into expanding this lawsuit just so they could win it?

9 MR. SLIFKIN: No, I'm suggesting they didn't
10 want us to be able to question the witnesses about why they
11 made the change or the timing of the change coming on the
12 heels of an amendment to include a new patent.

13 THE COURT: Let's talk about the relief you are
14 seeking. It does seem quite excessive even if you are right
15 about all of what they were doing. Help me understand why
16 I should give you everything that you are asking for.

17 MR. SLIFKIN: Well, Your Honor, I think
18 certainly we believe certain sanctions are needed here. We
19 were deprived of the opportunity to take those washer size
20 documents and put them in front of the witnesses and ask
21 about why were the changes made? Who made the change? Are
22 there other communications about the change? Were there
23 e-mails about change?

24 We just didn't know that they had made a
25 production change. We have evidence of experimentation. So

1 we were deprived of the discovery opportunity to ask these
2 witnesses a whole series of questions about the change.

3 If the Court has other sanctions, we would
4 certainly accept whatever the Court deems appropriate. We
5 believe an alternative sanction would be to, on the
6 infringement of the '715 patent, to shift the burden of
7 proof to the defendants to prove they don't infringe.

8 Clearly, the 16 thousandths washers that were
9 causing infringement, the evidence is clear, as much as they
10 try to hide the fact in their papers about they mention some
11 larger washer size, they never used a larger washer size in
12 production. It's either, it was either 16 thousandths or 14
13 thousandths. The 16 thousandths allowed the solder to free
14 flow to the gold, according to Mr. Rios, and Professor
15 Webster.

16 THE COURT: Well, why not just let this all play
17 out in front of the jury?

18 MR. SLIFKIN: Well, Your Honor, again, we've
19 been deprived the opportunity to ask these witnesses
20 questions. We now are faced with not knowing what Mr. Rios
21 is going to say or Mr. Panlener is going to say about the
22 change in the washer size, the difference of it, how long
23 the infringement was going on before they tried to fix it.

24 There is a substantial gap in time that has never
25 been explained from November 2011 to March or later 2014

1 when they fixed the problem. That gap has never been
2 explained in any of their papers. We have to hear it for
3 the first time from the witnesses on the witness stand.
4 It's somewhat unfair for us to have to react to that when we
5 could have asked about that gap, had we known they had made
6 a production change.

7 The confusion is evident not only from
8 Ms. Smalley's examination of Mr. Rios but my examination of
9 Mr. Webster where I put document after document in front of
10 him for the 16 thousandths washer size and says, each one of
11 these show 16 thousandths. What documents do you have to
12 show 14 thousandths? And he said he hadn't seen any.

13 Of course, counsel had those documents or
14 their client had those documents. We were deprived of the
15 opportunity to put those documents in front of Mr. Webster
16 and say, isn't it a fact that there is a change made and you
17 examined products made after the change?

18 I mean that is yet another issue, Your Honor, is
19 the samples that we looked at, according to them, I believe
20 they say now the samples they gave us were 14 thousandths.
21 We never had an opportunity to test the 16 thousandths.

22 I know from their papers they handed to me
23 before the argument here, they're going to say the DPA
24 samples, the DPA samples were 16 thousandths, and you had
25 those. Those are the same samples they're saying are

1 unreliable because of the DPA process.

2 What we're talking about, Your Honor --

3 THE COURT: I understand. Thank you. Let me
4 give them a chance.

5 MR. SLIFKIN: Yes, Your Honor.

6 THE COURT: Thank you.

7 Good morning.

8 MR. CAHILL: Your Honor, I have some slides, and
9 I'd like to hand them up.

10 THE COURT: Okay.

11 (Documents passed forward.)

12 MR. CAHILL: However, Your Honor, given how
13 tight we are on time, if there are specific issues that the
14 Court would like to inquire about, I'm happy to skip through
15 and simply answer questions.

16 THE COURT: Well, I guess start with the
17 contention that this is at a minimum unfair that we're all
18 going to hear at trial evidently what your client's view is
19 as to when the design change occurred, why it occurred, when
20 infringement ended, and when it was ongoing. Wouldn't that
21 be unfair to subject everyone to?

22 MR. CAHILL: Well, none of that is exactly true,
23 Your Honor. So the testimony is that there were parts that
24 failed inspection, driving up the defect rate, and that when
25 Mr. Rios analyzed those parts, he discovered that for those

1 parts -- this isn't for every part. For those parts, the
2 solder had flowed through. Those parts were scrapped.

3 There is no evidence that there was widespread
4 infringement. That never happened. In fact, throughout the
5 time period that we're talking about, AVX made primarily
6 platinum pin Ingenios for which there was never any problem
7 with the solder flowing through. It was only for certain
8 palladium pins and certain parts where this phenomenon was
9 seen.

10 THE COURT: When did you change to the 14
11 thousandths?

12 MR. CAHILL: I believe that is early in 2014.
13 It's hard to tell exactly because new pin washers were being
14 ordered. It's hard to tell exactly when they became
15 standard usage on the factory floor.

16 THE COURT: And is that going to be part of your
17 defense in this case?

18 MR. CAHILL: The date on which the pin washers
19 changed?

20 THE COURT: Yes.

21 MR. CAHILL: I don't think so, Your Honor.

22 THE COURT: How about the fact that they changed?

23 MR. CAHILL: It's a relevant fact. And if I
24 could, I'd like to bring up one slide.

25 So this is from Greatbatch's primary expert,

1 Professor Pilgrim. This is from his initial report. And he
2 recognizes pretty clearly.

3 And, by the way, he investigated DPAs of
4 Ingenio, more than 150 of them, throughout the time from
5 2011 to 2015 and that is what he is talking about here.

6 There were two parts each from 87 lots.
7 Actually, one of them had a third part. I think it came out
8 to some number of Ingenio parts that he reviewed. And as he
9 correctly notes, the issue on infringement is not the size
10 of the pin washer. The key issue is whether solder contacts
11 gold directly.

12 Now, he opines that he is able to tell from the
13 evidence that he has whether Ingenio parts infringed over
14 time.

15 We think that same evidence shows that they
16 don't. That is the issue that is going to go before the
17 jury.

18 THE COURT: But isn't the diameter or size of
19 this pin probative or at least arguably related to the
20 likelihood of that contact occurring and therefore there
21 being infringement?

22 MR. CAHILL: It's relevant.

23 THE COURT: It is relevant?

24 MR. CAHILL: It is relevant.

25 THE COURT: It is going to be an issue at trial,

1 isn't it?

2 MR. CAHILL: It's relevant, Your Honor. We
3 expect it to be part of the evidence.

4 THE COURT: So how is it fair then to the
5 plaintiff that they be made to go forward having to face
6 that evidence when it was not produced in a timely manner
7 during discovery?

8 MR. CAHILL: Well, the evidence was produced in
9 a timely manner. There were five documents that were not.
10 There was clear testimony that the pin washer size changed.

11 THE COURT: In or around early 2014?

12 MR. CAHILL: I don't know that the date was
13 specified. There were testing.

14 THE COURT: Who is the witness that you say
15 clearly testified that it was changed?

16 MR. CAHILL: So two witnesses testified.
17 Roberto Rios testified.

18 THE COURT: Isn't it conceded that his testimony
19 was murky and unclear?

20 MR. CAHILL: No, it was not. Not in any way,
21 shape or form. I think it is crystal clear.

22 THE COURT: Okay. Show me that.

23 MR. CAHILL: The one place -- and this is in
24 Exhibit F to our brief. There is a section of Mr. Rios.
25 I'm sorry, it is not Exhibit G, it is Exhibit H. There is a

1 section of Mr. Rios' testimony from pages 110 to 111.

2 And at 110, 11 and 12, Mr. Rios is asked: And
3 the current Ingenio product the pin washer has an inner
4 diameter of 16 mils; correct?

5 And he says: Uh-huh, right.

6 THE COURT: Didn't your attorney say on the
7 record that the record got a little muddled and therefore I
8 want to clarify things?

9 MR. CAHILL: So if I could just follow up a
10 little bit, Your Honor.

11 So Mr. Rios got it wrong there. I think he
12 misunderstood the premise of the question and then starting
13 at the first line of page 111, this is seconds after that,
14 the question is: Okay. Are you currently using palladium
15 iridium?

16 That is in reference to the pins in the Ingenio
17 product.

18 And the answer is: We're currently using that
19 with the 14 thousandths diameter washer ID, no split.

20 I don't know how it could be clearer than that.
21 That is what they're using.

22 THE COURT: Is it true or untrue that your
23 attorney said on the record during that deposition that the
24 record was muddled?

25 MR. CAHILL: He did say that.

1 THE COURT: So how can I rely on this as the
2 clear disclosure by your client that there was a change in
3 the diameter?

4 MR. CAHILL: Mr. Rios said it more than once,
5 and my partner did in fact go back with Mr. Rios and clarify
6 it.

7 THE COURT: Who is the other witness that you
8 think made it clear?

9 MR. CAHILL: Professor Webster.

10 THE COURT: Who I thought indicated he had no
11 direct factual knowledge. He is your expert.

12 MR. CAHILL: His expert report clearly states
13 that the pin washer size was changed. And he states that in
14 his report after discussing it with Mr. Rios and
15 Dr. Panlener.

16 THE COURT: Was he then questioned in deposition
17 and indicated he had not seen any documents that supported
18 that?

19 MR. CAHILL: I don't recall that question
20 specifically. I do know that a number of documents were put
21 in front of him and he was asked the pin washer size and it
22 was 16 mils.

23 THE COURT: You say on page 7 of your brief,
24 production of purchase orders, you write: While it is true
25 that the produced core technical documents do not reflect

1 the pin washer change, it is not true, as AVX's witness
2 testified, that a design change did not occur. The purchase
3 orders confirm the evidence already of record and were
4 produced only to combat Greatbatch's sweeping assertions on
5 summary judgment. Right? Do you recall all that?

6 MR. CAHILL: Do I recall?

7 THE COURT: I'm reading it from your brief.

8 MR. CAHILL: Yes.

9 THE COURT: Do you doubt that I'm reading that
10 from your brief?

11 MR. CAHILL: No, that is what the brief says,
12 Your Honor.

13 THE COURT: Isn't it significant that it is
14 admitted that the core technical documents do not reflect
15 the pin washer change?

16 MR. CAHILL: That is a fact. That is why --
17 and, Your Honor, I am the one who went to try to sort this
18 out, and I'm happy to explain it to the Court.

19 We were surprised in Greatbatch's summary
20 judgment briefing when they argued that the core technical
21 documents did not show the change and, therefore, we should
22 be precluded from arguing that the pin washer ever changed.

23 I went back to the client and said, how could
24 this be? How is it possible that the size of the pin washer
25 changed but the Ingenio drawings didn't change?

1 And it actually took them a couple of weeks to
2 figure it out. The conclusion that they came to was in fact
3 they did make the change off spec. That they needed to make
4 the change because the defect rate was up, the yield rate
5 was down. Their customer was not going to be happy with
6 that, but they knew it would take a significant amount of
7 time in order to get an engineering change order through to
8 change the drawings.

9 So they talked to Boston Scientific about it and
10 simply made the change, and it wasn't reflected in the core
11 technical documents.

12 THE COURT: Is that explanation in the record?

13 MR. CAHILL: So ... not stated exactly like that.

14 THE COURT: Is it part of what you intend to
15 present at trial?

16 MR. CAHILL: At trial, our witnesses will say
17 that the change was made and that the Ingenio drawings were
18 not changed.

19 THE COURT: Will they say the reason for it had
20 to do with the high number of errors and Boston Scientific
21 and all of what you just outlined for us?

22 MR. CAHILL: So I think everything that I said
23 was said by Mr. Rios on his deposition except for the part
24 about talking to Boston Scientific, which I'm not sure we
25 would be able to put in at trial. But, in fact, he talks

1 about the defect rate and generating scrap and that was the
2 problem and that is why the change was made.

3 THE COURT: Does the record show that any
4 portion of the reason for changing the size here was to
5 avoid infringement?

6 MR. CAHILL: No.

7 THE COURT: We didn't get through much of the
8 timeline, but I'm sure you are familiar with it and a lot of
9 it is outlined in the papers. There is a suggestion that
10 what was going on here on your part was you knew they were
11 looking to amend their complaint and to avoid infringement
12 right at that same amount, same period of time generally,
13 you were undertaking these efforts to change the size here.
14 Respond to that.

15 MR. CAHILL: This change was driven by Mr. Rios
16 who was not involved in the lawsuit other than as a document
17 custodian who we interviewed and his documents to be collected.
18 He made this change because there was too much scrap, the
19 yield rate was coming down, and it was his job to fix that.
20 And that is why the change was made, not for any other reason.

21 THE COURT: There is a suggestion that you all
22 modified one of these drawings. What is response to that?

23 MR. CAHILL: So my understanding is that Mr.
24 Rios modified the drawings when he ordered the modified pin
25 washers.

1 THE COURT: And was it clear in production that
2 you had made a modification or was it an effort to mislead
3 the plaintiff?

4 MR. CAHILL: Certainly, there was no effort to
5 mislead ever, Your Honor. I had produced those documents
6 myself. There was never any intent on anyone's part to
7 mislead anyone. We produced all of the documents that the
8 client gave to us when I went to them and said are there
9 documents that show when the pin washer changed? They gave
10 me -- they figured out that purchase orders was probably the
11 best way to figure it out. They went and found some of the
12 document in the basement in the file cabinets and sent them
13 to me and I produced them.

14 Now, what the drawings reflect is Mr. Rios
15 ordering different sizes of pin washers by taking a pin
16 washer drawing and changing the dimensions. That is what he
17 did. That is how he ordered them.

18 THE COURT: Did the plaintiffs know that those
19 documents that you produced involved a change to the drawing
20 or did they have to just figure that out themselves?

21 MR. CAHILL: I think they figured it out
22 themselves but I didn't figure it out until they figured
23 it out.

24 THE COURT: Is there anything else?

25 MR. CAHILL: No. If the Court is happy, I'll

1 sit down.

2 THE COURT: Thank you. Okay. Is there any
3 response?

4 MR. SLIFKIN: I'll try to be brief, Your Honor.
5 I know we've got a lot to do today.

6 I'd like to invite the Court's attention, after
7 I get the technology to work -- (Elmo settings adjusted) --
8 to Professor Webster's report, paragraph 273, last sentence
9 on that page: AVX and BSC finally settled on using split
10 solder preforms and 15 thousandths pin washers.

11 So for them to say that the record is clear,
12 we know what size pin washers were being used, Professor
13 Webster, after speaking to presumably to Mr. Rios, now says
14 it's 15 thousandths, we don't have any documents showing 15
15 thousandths.

16 I'd also like to invite the Court to look at our
17 reply brief, page 7.

18 "Question: And in the current Ingenio products
19 the pin washer -- let me emphasize in the current Ingenio
20 products, the pin washer has an inner diameter of 16
21 thousandths. Correct?

22 "Answer: Uh-huh. Right."

23 Again, as the Court I think recognizes, as Mr.
24 Hall recognized, the record is muddled.

25 He is saying yes. And that is a question that I

1 think is not unclear or difficult for somebody to understand
2 even if English is their second language.

3 What is the current inner diameter?

4 Sixteen thousandths was the answer.

5 A couple of other minor points. We still don't
6 know, we still don't have an explanation for the discovery
7 in November of 2011, and the fix in April or March of 2014.
8 Yet again, AVX has declined to explain how this gap, this
9 huge gap in time can exist. If Mr. Rios was concerned about
10 the scrap rate, what was he doing for two years and two or
11 three months about it?

12 Scrap or defects is another word for infringement,
13 Your Honor. It is solder reaching the gold braze.

14 THE COURT: Well, we're told now it was all
15 driven by customers, and that was when they happened to
16 receive sufficient number of complaints from their customer
17 that they decided to do something about it.

18 MR. SLIFKIN: That may be, Your Honor. It would
19 have been nice for us to know about that so we could have
20 asked Boston Scientific about it and so we could have
21 requested communications between Mr. Rios or others with
22 Boston Scientific on the topic.

23 I also point out, Your Honor, that we have
24 document requests specifically mentioning the part number
25 of the washer. Those documents were not produced during

1 discovery. Those are the documents we got after the close
2 of discovery in the middle of summary judgment briefing,
3 and the requests can't be more clear. They mentioned the
4 part number, pin washer, part number, and those were never
5 produced to us during fact or even expert discovery.

6 Nor were certain process specifications, 2046,
7 Revisions N,O,P&Q were never given to us. We have M and we
8 have R. We are missing the ones in between. And we believe
9 there is ones after R that deal with what they now claim is
10 an unsplit washer when Revision R says to split the washer.
11 We don't have process specs.

12 What they do say is there was some off spec
13 change. That is attorney argument. They declined to give
14 us a declaration from a witness who could say whether or not
15 it was an off spec change.

16 The language in the brief says they could have
17 testified, not they would have testified, about the off spec
18 change. They could not have. They don't know. Maybe
19 we'll learn at trial, but unfortunately we have to request
20 those questions for the first time when we confront the
21 witnesses at trial.

22 THE COURT: All right. Thank you. We'll come
23 back to this. Let's move on to, there is one motion in
24 limine I want to hear brief argument on. That is AVX's
25 Motion in Limine No. 1 to preclude evidence of secondary

1 considerations of nonobviousness.

2 So let me hear from AVX on that first, please.

3 MR. RAWNSLEY: Thank you, Your Honor. AVX served
4 two interrogatories directly asking what are your contentions
5 on secondary considerations? The language of those
6 interrogatories, although they make brief reference simply
7 to names of what are acknowledged secondary considerations,
8 they say we will provide our contentions to you at some other
9 point. We never received any supplement explaining what the
10 contentions on those secondary considerations were.

11 THE COURT: Did you ever come to me and complain
12 their interrogatory responses were inadequate?

13 MR. RAWNSLEY: We did not.

14 THE COURT: And so why should I not treat this
15 as simply too late of a complaint?

16 MR. RAWNSLEY: Well, because secondary
17 considerations is an issue on which they would bear the
18 burden. As we set forth in our expert testimony, in the
19 expert reports, it said this is our prima facie case of
20 obviousness. The burden now goes to you to let us know
21 if you are going to try to rebut under secondary
22 considerations. That was explicitly set forward.

23 Not one of the expert reports we received in
24 response actually addressed secondary considerations from
25 the plaintiff.

1 THE COURT: Now, they do point to at least 300
2 plus pages of places where the evidence that they want to
3 now characterize as secondary considerations was in the
4 record in front of you in a timely manner. Do you disagree
5 that you had all of that evidence in a timely manner?

6 MR. RAWNSLEY: We do not disagree those were
7 documents produced during fact discovery; and to the extent
8 they were produced within the deadlines, it is true that
9 they were produced in a timely manner.

10 THE COURT: So why isn't that enough? You
11 knew they had secondary considerations in mind from their
12 admittedly vague responses to your interrogatories. You
13 didn't come and ask for more specific interrogatories from
14 the Court, and you have all the evidence that they want to
15 use. Why, when I weigh all that, shouldn't I say let's deal
16 with it, let's hear this evidence at trial.

17 MR. RAWNSLEY: Because of the fact we don't
18 have the evidence we want to use. Because issues such as
19 commercial -- let's take commercial success, for instance.
20 Simply their evidence that they cite for commercial success
21 is simply a spreadsheet. That is something that requires
22 expert testimony. That is something that necessarily is
23 going to require expert testimony to put in context and
24 explain.

25 They say simply because we sold this product,

1 here are the numbers. That puts nothing in context. That
2 is annum are tore. There is no denominator. There is
3 nothing to explain to the jury. And we have been deprived
4 because they did not put in expert testimony on the an issue
5 they bore the burden.

6 We now have no expert testimony in the record
7 that would allow us at trial to rebut that.

8 THE COURT: All right. Thank you. Let me hear
9 from Greatbatch.

10 MR. MULDOON: Your Honor, the secondary indicia
11 of nonobviousness, as the Court has recognized, there is
12 300 pages, over 30 exhibits going to deposition testimony.

13 THE COURT: All right. But it is true that
14 the first time you ever characterized that as evidence in
15 support of secondary considerations is in the motion in
16 limine response?

17 MR. MULDOON: Your Honor, as the local rules
18 made clear, the specificity with which someone asks or
19 answers questions is often related to the specificity with
20 which that party responds to interrogatories.

21 Had this been made as a motion at the time
22 that this is somehow unfair, we could have gone through and
23 shown a number of interrogatories that were at least as
24 vague and nonresponsive, at least vague as our interrogatory
25 presently.

1 THE COURT: So you agreeing the first time any
2 of us would have understood this is the evidence you intend
3 to present as part of your secondary considerations is in
4 your response to the motion in limine?

5 MR. MULDOON: No, Your Honor, I don't. Robert
6 Beckman, financial specialist at Greatbatch, had testified
7 with respect to sales of specific items both in this action
8 and in the related IPR proceeding. He submitted a
9 declaration there pursuant to an e-mail agreement between
10 Mr. Whetzel and myself.

11 The testimony provided in the IPR was equally
12 available and usable in this proceeding. So Mr. Beckman's
13 testimony and the arguments with respect to commercial
14 success of specific models was presented in that case and
15 argued in the IPR.

16 THE COURT: At what point did the defendant first
17 learn that Mr. Beckman's testimony was going to be used by the
18 plaintiff as part of its secondary considerations showing?

19 MR. MULDOON: His declaration I believe was
20 submitted in January 15, I believe, Your Honor.

21 THE COURT: Does it indicate it has anything to
22 do with secondary considerations?

23 MR. MULDOON: Yes, Your Honor. And the patent
24 owner's response in the IPR, there is a reference to secondary
25 indicia of nonobviousness on commercial success that cites

1 to Mr. Beckman's very short declaration regarding sales of
2 specific part numbers. There are also interrogatory responses
3 that identify all of the components that are practicing the
4 patents, that are manufactured by Greatbatch and substantial
5 sales volumes regarding the sales of each of those items.

6 There is testimony that was taken of Mr. Marzano
7 and Mr. Seitz regarding Greatbatch's practice of designing
8 in the specific technology that it has patents on into the
9 products. That was covered in depositions, portions of
10 which are present.

11 Clearly, the nexus, the tying of the patented
12 products and the commercial success were set forth in
13 numerous documents as well as referenced in Mr. Strickland's
14 report with respect to commercial success of products that
15 is mentioned I believe in Mr. Strickland's report.

16 And even in the patent itself, there is evidence
17 of disclosure of unexpected results in the specification
18 with respect to the tendency of the body to absorb certain
19 RF frequencies that permit the 267 internally grounded
20 filter capacitors to work in this type of application.

21 THE COURT: Do you have any expert opinion that
22 has been disclosed with respect to secondary considerations?

23 MR. MULDOON: I believe that Mr. Stevenson's
24 expert report deals with I believe some -- I'd have to -- I
25 don't recall the specifics, but I believe there is both

1 evidence of secondary indicia of nonobviousness in both Mr.
2 Stevenson and Mr. Strickland's report that are tied to those
3 issues.

4 THE COURT: So if I deny their motion, your
5 intent is to present expert opinion through Mr. Stevenson
6 and Mr. Strickland to support your showing of secondary
7 considerations of nonobviousness?

8 MR. MULDOON: Well, also obviously people from
9 Greatbatch who will support both the sales of the identified
10 products that Greatbatch manufactures that incorporate the
11 patented technology and the individuals who routinely assess
12 those issues and intentionally design the technology into
13 Greatbatch's products.

14 THE COURT: Right. But all of those are fact
15 witnesses; correct?

16 MR. MULDOON: Those are fact, yes.

17 THE COURT: But in terms of, the suggestion from
18 the defendants is you have no expert opinion disclosed in
19 the context of secondary considerations of nonobviousness.
20 And you say that is incorrect. We have Stevenson and
21 Strickland.

22 MR. MULDOON: Yes, Your Honor.

23 THE COURT: All right. Thank you. Let me hear
24 the reply.

25 MR. RAWNSLEY: Briefly, Your Honor. There has

1 been no agreement to use everything in the IPR as if it
2 were in this litigation. There was agreement solely as to
3 Professor Stevenson's testimony. I don't believe the
4 declaration -- I could be wrong on this but I don't believe
5 that the declaration he was referring to of Beckman from the
6 inter parties review has even been entered into the record
7 in this case. Mr. Beckman in this case is simply one of
8 many fact witnesses.

9 THE COURT: Whatever the agreement is, you agree
10 it is embodied in an e-mail?

11 MR. RAWNSLEY: Well, it is in a letter before
12 the Court. It's been submitted to the Court.

13 THE COURT: Okay. But whatever it is, it's in a
14 document.

15 MR. RAWNSLEY: Correct. Correct.

16 THE COURT: Okay.

17 MR. RAWNSLEY: Yes. And there is no agreement
18 as to everything in the IPR comes into this. As I said,
19 Beckman in this case is a fact witness. I'm not aware of
20 Professor Stevenson testifying as to secondary consideration.
21 Just pointing to the '627 patent to say there were results,
22 there has been no indication that those were unexpected
23 results. We certainly weren't aware of any, and we would
24 have put in expert testimony to the contrary, had we had any
25 opportunity to know that that was coming.

1 And as to Strickland's report, they insist there
2 was commercial success. Again, that depends on nexus, that
3 depends on a showing that their products practice claims of
4 this patent.

5 I ask Your Honor to follow the footnotes where
6 he says that our parts practice this. Follow the footnotes
7 and see if there is any technical expert testimony from a
8 Greatbatch expert that underlies those assertions. There is
9 none.

10 THE COURT: All right. Do you happen to know
11 where in the record we could find this agreement regarding
12 the IPR? If you don't, I'll give you time to look for it.

13 MR. RAWNSLEY: Yes. I'll be able to get it to
14 you briefly. It was in a letter submitted to Your Honor.

15 THE COURT: Okay.

16 MR. RAWNSLEY: And just one final response. To
17 date, we still don't know what their secondary considerations
18 are. We would like to know, if this were going to go forward,
19 exactly which claim they're asserting is practiced by which
20 patent and which secondary considerations, which nexus applies
21 to which. We still don't know that.

22 Their response to our motion in limine is the
23 interrogatory response that they should have provided more
24 than a year ago.

25 THE COURT: Is there anything further on this

1 one?

2 MR. MULDOON: No, Your Honor.

3 THE COURT: All right. Let's talk about one
4 more issue and then we'll take a break. Let's now come
5 to the request for supplemental claim construction that
6 Greatbatch requests.

7 MR. MULDOON: May I approach with a few slides,
8 Your Honor?

9 THE COURT: Yes, you may.

10 MR. MULDOON: Your Honor, as the Court may
11 recall, claim construction back in November of last year,
12 the issue with respect to conductive coupling dealt
13 primarily, if not solely, with whether or not it was to
14 include capacitive coupling. And that construction was
15 limited to the various references with respect to variations
16 of conductive coupling, conductively coupled, and all the
17 various tenses.

18 Well, after the Court had issued that
19 construction, which we believe is absolutely correct with
20 respect to what conductive coupling is, we are not asking
21 to have the Court change that construction with respect to
22 conductive coupling.

23 The dispute with respect to the claim limitation
24 is now a ground lead conductively coupled to the conductive
25 substrate. As it became apparent during the summary

1 judgment briefing where this issue was addressed with
2 respect to certain items of prior art, we do not believe
3 that, and which the Court has ruled there is questions of
4 fact as to whether they are prior art, but we believe it
5 would not be appropriate on both a motion in limine and on
6 our representation on our motion for AVX to represent in
7 questions or testimony that these various prior arts satisfy
8 that claim limitation by covering a structure that is
9 discussed in the patent in at least four different locations
10 and described as being eliminated by the novel aspect of the
11 present invention.

12 THE COURT: Are you essentially asking us to
13 find a disclaimer now in your patent?

14 MR. MULDOON: Yes, Your Honor. We believe that.

15 THE COURT: And did you ask me that when you
16 proposed the construction that I adopted?

17 MR. MULDOON: It wasn't at issue with respect to
18 the term until it was put in the context of the ground lead
19 limitation that was, has become an issue of disputed claim
20 scope since motion briefing was last summer, Your Honor.

21 THE COURT: All right. Try to show me briefly
22 then how I could find this disclaimer that you now see in
23 your patent.

24 MR. MULDOON: Yes, Your Honor.

25 The slides, please.

1 The patents-in-suit in the specification has, in
2 several locations, it identifies with respect to column 3,
3 and the line numbers aren't here. It's at the bottom of
4 column 3.

5 In particular, novel capacitor assembly is
6 needed that is subjected to far less temperature rise during
7 the manufacture thereof by eliminating an outer perimeter or
8 outside diameter electrical/mechanical connection.

9 Then moving on to the sentences that bleed
10 from, carry over from the bottom of claim 4 into claim 5,
11 the internally grounded monolithic feedthrough filter
12 capacitors utilized in the assemblies of the present
13 invention advantageously eliminate the need to conductively
14 couple a metallized exterior surface of the capacitor to a
15 portion of the conductive substrate or ferrule, as was
16 required in the prior art.

17 Moving over to the top of column 7.

18 The invention as described herein eliminates the
19 need for external conductive connections between the
20 capacitor and a ground by connecting the internal ground
21 plates to a ground pin, tublet or similar ground lead
22 structure.

23 Then finally in claim 10 of the specification
24 talks about the significant advantage of the novel
25 internally grounded feedthrough capacitor assemblies, that

1 the mechanical and electrical connection to the outside
2 diameter of the capacitor is eliminated.

3 This point, Your Honor, was carried over into
4 the Office Action of August 19th in the prosecution history.

5 That is viewable on the next slide.

6 That again shows that they're talking about
7 it's clear that the internally grounded feedthrough filter
8 capacitor of the present invention differs in an important
9 and novel aspect, namely, that the ground plane electrodes
10 are internally grounded to a capacitor through ... This is
11 in marked contrast to the prior art, wherein the ground
12 plane electrodes are grounded at the outer diameter or outer
13 periphery of the capacitor.

14 It even indicates this is what we talked about
15 throughout the application, the specification, in four
16 different locations that the claims are directed towards.

17 We believe that all of these points, a couple
18 of them would have been a clear disclaimer that the internal
19 grounding of the ground lead of the feedthrough filter
20 capacitor is accomplished by the ground lead being both
21 conductively coupled to the second plates as well as to
22 either the ferrule or the conductive substrate as set forth
23 in the various claims.

24 Plaintiff's interpretation of that collapses
25 both of those distinct limitations of the ground lead

1 limitation elements into a single one. That the ground
2 lead pin not only is coupled to the second planes but those
3 electrodes are there also used to externally ground the
4 part that has consistently been described as an internally
5 grounded part and distinguished as the invention eliminates
6 that external ground capacitor connection and the benefits
7 that that provides.

8 We are not requesting that the Court require
9 non-metallized external surfaces of the capacitor as in
10 claims 2 and 22. That is a different benefit that is
11 discussed elsewhere. Here, it is the fact that the ground
12 lead is eliminated to allow for a reduction in the
13 mechanical and thermal stresses on a capacitor and to
14 provide a means for helium lead detection that are disclosed
15 in specific paragraphs in column 10 of the patent.

16 Therefore, in light of the dispute that has arisen
17 over the claim construction, a ground lead conductively
18 coupled to the conductive substrate cannot be construed as
19 to include solely an external ground connection through the
20 exterior perimeter of the capacitor.

21 THE COURT: All right. Thank you. Let me hear
22 from the defendants.

23 MR. WHETZEL: I'll try to be brief, Your Honor,
24 in the interest of time.

25 First, this isn't a new issue. It should have

1 been raised at claim construction. It was a legitimate
2 issue. We submitted in June of 2014 our initial invalidity
3 contentions. They're attached to our MIL No. 3.

4 In those contentions, we very clearly set forth
5 the conductive coupling structure and arrangement that we
6 believe is found in the prior art devices.

7 Interestingly, in September of 2014, Greatbatch
8 went to the Patent Office with a reissue application which
9 is also cited in our papers and they sought a new dependent
10 claim that would include essentially the limitation that
11 they're asking this Court to import into claim 12 -- I'm
12 sorry -- into claim 11.

13 Claim 11 is a very broad claim, Your Honor. Your
14 Honor has construed the operative language, "conductively
15 coupled." You adopted Greatbatch's construction. And the
16 one thing we didn't see during plaintiff's presentation this
17 afternoon was the language of claim 11, and I would invite the
18 Court's careful scrutiny of that language.

19 Interestingly, their own expert has testified
20 that any electrical conductive path between the ground pin
21 and the ferrule would constitute a conductive coupling. And
22 that testimony is also set forth in our papers.

23 The entire fact, prior art disclosure and
24 expert discovery in this case has been predicated on the
25 Court's claim construction to inject this new position,

1 this new issue would be both untimely, prejudicial, and, in
2 addition, it's not supported by the language of the claim or
3 by the language of the patent.

4 Greatbatch is asking the Court to import a wholly
5 new limitation into a very broad claim, claim 11. It's a
6 little hard to even parse the language they suggested. But
7 as best I can tell from their brief, the language they're
8 asking the Court to insert is along the lines of wherein the
9 conductive coupling excludes pins that are not connected to
10 the substrate independently of the capacitor.

11 That is classic dependent claim language, Your
12 Honor. That is not construing what "conductive coupling"
13 means. That is adding new limitation to narrow and
14 circumscribe the electrical path of the physical locations
15 for that conductive coupling. We urge the Court to reject
16 these belated and untimely efforts to rewrite the claim as
17 unsupported by either the language of the claim or the
18 specification.

19 As to the claim scope disavowal argument, Your
20 Honor is keenly aware of the very strict standard to find
21 claim scope disavowal based on recent opinions the Court has
22 issued.

23 The standard for finding implicit standard is
24 exacting and it must be so clear it disclaims it explicitly.

25 On its face, the argument that frankly the claim

1 scope is disclaimed in the prosecution history conflicts
2 with Greatbatch's argument that that limitation is somehow
3 found in the scope of claim 11.

4 Finally, as to the prosecution history document
5 where they distinguished the '095 patent, Your Honor,
6 Greatbatch is confusing the presence of an internal ground
7 connection, which is what the '627 patent is about, with the
8 absence of metallized exterior surfaces which admittedly is
9 found in certain dependent claims and other claims of the
10 patent, one independent claim, each of which coincidentally
11 have been invalidated by the PTAB. That limitation is not
12 found in claim 11, and we respectfully urge the Court not
13 to import it into claim 11, particularly at the 11th hour.

14 Thank you.

15 THE COURT: Thank you. Brief rebuttal.

16 MR. MULDOON: Yes, Your Honor.

17 Again, my opponent is attempting to read
18 additional claim limitations into our position here. We have
19 never asserted that as the absence of non-metallized surfaces
20 that is a required claim limitation. They can be there. They
21 just can't be used to make the external electrical connection
22 of the outer perimeter of the capacitor to the conductive
23 substrate or the ferrule.

24 We suggest that the claim language, the term be
25 construed such that the conductive coupling of the ground

1 lead to the conductive substrate be independent of an
2 external electrical connection of the capacitor.

3 THE COURT: All right. Thank you. So we're
4 going to take a break. You're free until 1:00. I'll come
5 back as close to 1:00 as I can, and we'll be done by 2:00
6 o'clock. We will be in recess until at least 1:00.

7 (Brief recess taken.)

8 * * *

9 (Proceedings reconvened after recess.)

10 THE COURT: Have a seat.

11 All right. So you all have said a lot. Let me
12 say a few things pretty much focused on the issues that have
13 already been discussed today.

14 So, first, we have the defendants' motion for
15 reargument and clarification and the related issues regarding
16 the '627 patent and infringement.

17 Having reviewed the briefing and the record
18 such as it is at this point and heard the argument, I have
19 decided to deny the defendant's motion because the Court
20 hereby rejects AVX's position. That is, the Court is not
21 resolving infringement as a matter of law in favor of the
22 defendant, so there will be no summary judgment of
23 noninfringement on the '627 patent.

24 Symmetry, in the Court's view, is not
25 necessarily and always evaluated with respect to the first

1 and second passageways. This is all in the context of claim
2 12 of the '627 patent. There is no disclaimer in the patent
3 or any other basis to limit the claim scope in the way that
4 the defendants motion argues.

5 Further, another way to put it, is the Court
6 is not persuaded that as a matter of law, the hole of the
7 feedthrough filter capacitor is what we talked about as
8 being a dashed line box in the figure at page 5 of the
9 motion.

10 So the Court's Order is to deny the defendants'
11 motion. There will not be summary judgment of noninfringement.

12 Whether, however, the '627 patent infringement
13 question is a question of fact for this jury or whether
14 instead it can, and should be, resolved as a matter of law
15 in favor of the plaintiff is an issue I have not decided,
16 and it's an issue that I hereby direct the parties to meet
17 and confer on. And I would like your proposals tomorrow as
18 to whether or not you are in agreement on whether it is a
19 fact question or a question of law. And if you are not in
20 agreement, then I would like your proposals on what, if any,
21 additional briefing or assistance you will give me on how I
22 resolve that now somewhat narrowed question.

23 I turn next to Greatbatch's motion for sanctions.

24 This motion is denied but without prejudice to
25 be renewed at trial consistent with my comments now. And

1 those comments begin by I am certainly troubled by much of
2 what is alleged in the motion and particularly concerned to
3 learn only in connection with the motion I think in part
4 even just today what appear to be basic facts about why this
5 design change was made, when it was made, and that at least
6 in the defendants' view, the change had nothing to do with
7 a concern about infringement or setting up a noninfringement
8 defense.

9 I'm certainly concerned that the plaintiff may,
10 if the defendant is left free to do as it evidently wishes
11 to do at trial, the plaintiff may be unfairly prejudiced at
12 trial by learning material information that should have come
13 out in discovery only during the course of trial.

14 That said, I'm not yet persuaded that the
15 plaintiff cannot get a fair trial with respect to this patent.
16 I believe it's the '715 patent.

17 Part of what I'm going to do in an effort to
18 ensure hopefully a fair trial to both sides is I will treat
19 as relevant all of this back and forth about discovery, the
20 various disputes, what was produced and when, what was not
21 produced, whether a witness was clear or not in a deposition,
22 all of that which I would believe under normal circumstances
23 would be irrelevant because it is essentially an opportunity
24 to refight discovery disputes in front of the jury, I believe
25 in the circumstances of this case, all of that is likely to

1 be relevant and admissible because I imagine it will be
2 probative of what weight the fact-finder should give to each
3 side's showing with respect to infringement or noninfringement
4 of this patent.

5 The requested relief from the plaintiff,
6 however, in its motion, and even today, is too broad. I'm
7 not going to shift the burden of proof to the defendants.
8 I'm not going to deem that all products before the change
9 were necessarily infringing. And I'm not going to deem as
10 a fact that there was no design change when we all now know
11 there was a design change.

12 If the plaintiff believes that additional
13 relief narrower than what it has asked for to this point is
14 warranted by how things play out at trial, the plaintiff
15 will have to ask for that relief at trial.

16 That takes me now to the motions in limine.
17 I'll start with the one that was argued, AVX's Motion in
18 Limine No. 1 to preclude Greatbatch from offering evidence
19 regarding secondary considerations of nonobviousness.

20 This motion is granted. In the Court's view,
21 there was not full, fair and proper disclosure in connection
22 with discovery, particularly in response to interrogatories
23 of the plaintiff's position with respect to secondary
24 considerations, an issue on which the plaintiff bears the
25 burden.

1 Having reviewed the materials that the parties
2 provided and heard the argument today, I remain unconvinced
3 that the handling of this issue by the plaintiff is
4 consistent with what we expect under the Rules of Civil
5 Procedure which ultimately is to make sure that nobody is
6 surprised when they get to trial as to what the other side
7 is trying to prove. And I'm afraid were I not to grant this
8 Motion in Limine No. 1, that would be the result. So the
9 Motion in Limine No. 1, AVX's Motion in Limine No. 1 is
10 granted.

11 Let's talk about the remaining motions in limine
12 which were not argued.

13 To preclude negative references to the number
14 of samples of accused products available to Greatbatch, that
15 motion is denied.

16 The plaintiff tested the three samples made
17 available to it of the Ingenio product. Evidently, that
18 was not enough for a statistical analysis. And I do recall
19 there was a lot of litigation over the course of discovery
20 about the plaintiff's access to parts and what the
21 defendants needed to produce. The plaintiff essentially
22 argues that the defendants, despite my ruling, stonewalled
23 and the defendants argues essentially that the plaintiff
24 strategically refused to examine more parts that were made
25 available.

1 All I can say is having relived all of this in
2 the course of reviewing the motion as well as having lived
3 it in real-time, I made the rulings I made. I tried to be
4 fair to both sides. It's unclear to me even today that one
5 side or the other was in whole or in substantial majority
6 the good guy or the other was the bad guy. And so under
7 these circumstances, A, I'm not going to preclude the
8 parties from arguing whatever they want to argue regarding
9 the number of products that were made available to
10 Greatbatch.

11 I think in fairness, both sides should be able
12 to make their argument. We only had three. We wanted more.
13 They didn't give us more. We offered them more. They
14 didn't take up the opportunity. You can put all of that in
15 front of a jury, if you want. I think it is all probative
16 of the weight that the fact-finder may give to the evidence,
17 for instance, the evidence regarding testing and whether or
18 not there is infringement and, if so, how far does that
19 infringement go.

20 I believe it is relevant. The Rule 403 balance
21 is admittedly a very close call. Generally, I would not let
22 you refight discovery battles in front of a jury, but for
23 the reasons I stated in connection with the motion for
24 sanctions and now more specifically in connection with this
25 motion, I think this is the unusual case where on balance

1 the probative value of putting these discovery disputes
2 before the jury outweighs the risk of unfair prejudice,
3 confusion and the other concerns of 403.

4 Next is Greatbatch's Motion in Limine No. 2 to
5 preclude AVX from presenting undisclosed expert opinion.
6 This motion is denied in part and granted in part.

7 I should say I think it would be within my
8 discretion to deny the motion in whole on the basis that it
9 is really at least three different motions combined into
10 one, but I'm not denying it on that basis.

11 It is, however, denied with respect to Dr.
12 Panlener.

13 This witness has relevant factual evidence based
14 on his experience and will be permitted to testify as a fact
15 witness on issues, for example, and these are just examples,
16 development and testing of the accused products, and the
17 existence of certain prior art. He has direct factual
18 experience and knowledge that he is qualified to testify
19 about on those issues.

20 He will not, however, be permitted to testify as
21 an expert and express an opinion, for example -- and, again,
22 just an example. He will not be permitted to compare the
23 prior art to the claims of the patent-in-suit.

24 If at any point Greatbatch believes that AVX is
25 crossing the line I am setting, they can object to specific

1 questions at trial.

2 With respect to Dr. Webster, the motion is
3 granted in that Dr. Webster, like all experts, will not be
4 permitted to testify to opinions that are not disclosed in
5 his report or declarations or deposition testimony. I will
6 implement that principle equally at trial with respect to
7 both sides.

8 And I note just because the Court did not
9 strike a particular obviousness combination does not mean
10 that every or any expert necessarily gets to testify about
11 it if he or she did not previously and properly disclose an
12 opinion with respect to that combination.

13 Finally, with respect to Dr. Webster, the motion
14 is also granted in that he will not be permitted to testify
15 on indefiniteness, nor will anyone else that the Court has
16 resolved that the patent is not indefinite as a matter of
17 law, which is an issue I think we made clear in our summary
18 judgment motion -- or summary judgment opinion.

19 That takes me to Greatbatch Motion in Limine No.
20 3, which is to preclude evidence or argument regarding the
21 IPR with respect to the '627 patent. This motion is granted
22 in part and denied in part.

23 I should actually say the only extent to which
24 it is denied is that the parties have evidently reached a
25 stipulation that just because evidence was presented in the

1 IPR doesn't per se make it inadmissible in this trial. So
2 in most respects, it is granted, and let me try to explain.

3 Under Rule 403, I believe that the risk of
4 confusion of the jury, the risk of unfair prejudice to the
5 patentee and the I think enormous amount of time that would
6 be required in order for both sides to be able to fairly
7 present their positions, both substantively and procedurally
8 with respect to what has happened in the IPR, what has not
9 happened in the IPR with respect to claim 12, what remains
10 to be done, the different burden of proofs, the different
11 claim construction standards, the implications of the
12 finding with respect to claim 11 for claim 12 and all of
13 that I think would take a great amount of time. I'd have to
14 allow it all to be put in front of this jury. I'm already
15 allowing enough to be put in front of this jury.

16 All of that I believe substantially outweighs
17 whatever probative value there is to the final written
18 decision and the status of the IPR that the defendants seek
19 to put in front of this jury.

20 I recognize there is some probative value to
21 that, but it is not nearly what defendants suggest. If I
22 understand that correctly, defendants are arguing that all
23 of the claims that are in the IPR are currently invalid. I
24 don't understand that to be the law.

25 As I understand the law, the patent is valid

1 unless and until the PTAB's decision is upheld by the
2 Federal Circuit or the plaintiff decides not to take an
3 appeal. My understanding is there is an appeal pending or
4 at least at the time before such an appeal has not yet run.

5 In addition, of course, with respect to claim
6 12, the PTAB found for whatever reason that there is not
7 even a reasonable likelihood that the defendant, under a
8 lower standard of proof, could prove that that claim is
9 invalid. So there is some probative value, but there is a
10 great, great deal of countervailing risk of prejudice and
11 confusion and the other concerns of Rule 403 and, therefore,
12 I'm not allowing that in.

13 Again, just to try to be clear, that does not
14 mean that evidence is inadmissible just by virtue of the
15 fact that it was also part of the IPR. If you take proper
16 care to redact, to instruct your witnesses not to mention
17 the IPR or the PTAB, then certainly you can use evidence
18 that might otherwise be proper even though it was part of
19 the IPR. And I understand that to be consistent with what
20 the parties have agreed on.

21 Next is AVX's Motion in Limine No. 2, to
22 preclude Greatbatch from being awarded damages on tests for
23 scrapped parts.

24 This one is granted in part. It is granted with
25 respect to lost profit damages. Greatbatch is not permitted

1 to seek lost profit damages for parts never sold. In all
2 other respects, the motion is denied.

3 The statute gives the plaintiff a right to
4 seek and obtain at least a reasonable royalty damage for the
5 infringement, including infringement by making tests for
6 scrapped parts.

7 AVX can object, of course, to expert testimony
8 that it believes is beyond the scope of what was disclosed
9 prior to trial.

10 And, relatedly here, Greatbatch asks for an
11 opportunity to supplement its expert report to indicate that
12 reasonable royalties apply to scrapped units. This request
13 is denied as untimely.

14 Finally for the motions in limine, AVX's Motion
15 in Limine No. 3, to preclude Greatbatch from misrepresenting
16 the limitations or scope of the '627 patent and some related
17 prior art, this motion is denied.

18 Arguably again here, this motion is really
19 multiple motions and could be denied on that ground alone.
20 I'm not denying it on that basis. I am denying it on the
21 ground that the issue of the scope of the prior art, whether
22 prior art is analogous or not, all of that implicates fact
23 questions relevant to obviousness and is properly before the
24 jury.

25 So, for instance, testimony that AVX seeks to

1 exclude regarding whether the '627 patent is or is not
2 limited to medical devices, that is relevant evidence and
3 should be admitted as it is probative of issues such as
4 whether certain prior art would be considered by a person of
5 ordinary skill in the art and relevant to the motivation to
6 combine.

7 Of course, no party will be permitted to
8 intentionally mischaracterize any evidence, including the
9 scope of the patents, but all of the issues that AVX
10 presents in its motion and suggests are mischaracterization
11 of the evidence I view instead as fair game and different,
12 reasonably different points of view as to the fair
13 inferences from the evidence.

14 Now, it's with respect to this motion that I
15 believe the request to clarify the claim construction by
16 plaintiff comes up and we heard argument separately on that.
17 This goes back to the '627 patent and the "conductively
18 coupled" term. Plaintiff's request that we construe the
19 term or modify our construction is denied.

20 At bottom, the plaintiff's position is based
21 on an alleged disclaimer in the patent. I'm not persuaded
22 there is a disclaimer. The burden is high and was accurately
23 characterized by the defendants in the argument and especially
24 in light of the claim differentiation arguments here, I am not
25 persuaded that there is a disclaimer. Therefore, the

1 plaintiff's request is denied.

2 I want to spend most of our limited time talking
3 about the remaining issues in dispute, but I have now said a
4 lot. Are there any questions about what I ruled from the
5 plaintiff?

6 MR. SLIFKIN: No, Your Honor.

7 MR. MULDOON: (Shaking head no.)

8 THE COURT: Okay. From defendants?

9 MR. WHETZEL: No, Your Honor.

10 THE COURT: No? Okay. Let's talk about some
11 of these miscellaneous or additional issues.

12 First, on my list is whether the issue of
13 alleged improper inventorship should be presented to the
14 jury or deferred to a bench trial. Let me hear from the
15 plaintiff on that, if it continues to be your view that
16 all of that should be deferred.

17 MS. SMALLEY: Yes, Your Honor.

18 Basically, our position is set out in our
19 Exhibit 16 but clearly inequitable conduct, and I think the
20 defendant has conceded, is an issue for the Court. Under
21 the *Shum* case, the 256 correction of inventorship is for the
22 Court. And the defendants' answer makes clear that they
23 are alleging the patent is either invalid or enforceable due
24 to inequitable conduct, not simply invalid due to a mistake,
25 innocent mistake in inventorship. So we believe that the

1 inequitable conduct, including inventorship, should be tried
2 to the Court.

3 THE COURT: Let me stop you. If we don't let
4 them say inequitable conduct and we just focus them on the
5 alleged basis for invalidity of improper inventorship, why
6 shouldn't we let this jury resolve the facts that underpin
7 that defense?

8 MS. SMALLEY: Well, first, I don't think it was
9 ever actually innocent or innocent mistake and inventorship
10 was never pled, so it was always intentional. I think however
11 you phrase it, that is in essence inequitable conduct.

12 If the Court were to find that it has been pled
13 properly and can be presented to the jury, then the issue
14 is simply whether Bob Stevenson contributed to the invention
15 and they shouldn't be able to argue his motive for intent,
16 because that throws it right back into inequitable conduct.

17 THE COURT: Do you anticipate bringing
18 Mr. Stevenson to trial to testify?

19 MS. SMALLEY: Yes.

20 THE COURT: So as part of a fair
21 cross-examination, wouldn't I have to let them get into
22 whatever intent or motivation Mr. Stevenson may have on
23 any issues in this case?

24 MS. SMALLEY: Normally I would say yes, but I
25 think if you are talking about him intentionally

1 misrepresenting his inventorship status to the Patent Office
2 and filing a false declaration, that's just redressing the
3 inequitable conduct claim.

4 THE COURT: All right. Thank you. Let me hear
5 from the defendant.

6 MR. RAWNSLEY: Your Honor, misjoinder of
7 inventorship under Section 102(f), inequitable conduct, are
8 distinct legal defenses. AVX pled both. It pled both in its
9 answer. It says invalidity and it says inequitable conduct.

10 They have different requirements. To prove
11 inequitable conduct, we have to show that material
12 information was intentionally withheld from the Patent and
13 Trademark Office. To show misjoinder of inventorship, we
14 have to show there was not a contribution to at least one
15 claim that is corroborated that was significant and that
16 there was collaboration with the other inventor.

17 AVX has continually taken a position throughout
18 this lawsuit that it is proceeding on both, and it always
19 has. I can point the Court to many instances, but just
20 right here is our summary judgment motion. AVX Filters
21 respectfully moves this Court for summary judgment of
22 invalidity under 35 Section 102(f).

23 THE COURT: All right. So if I let you do this,
24 how can I be sure you are not going to try to suggest or
25 argue to the jury that there is some inequitable conduct here?

1 MR. RAWNSLEY: Well, the inequitable conduct
2 turns on the submission of the false affidavit. That simply
3 is not anything we need to prove to invalidate the patent
4 under Section 102(f).

5 Now, the evidence that he is not an inventor is
6 what it is, and we should be able to put that on. But we
7 are under no obligation to disprove that he is an inventor
8 with reference to his submission of a false affidavit to the
9 Patent and Trademark Office.

10 THE COURT: Do you need to get into his intent?

11 MR. RAWNSLEY: I cannot stand here and say
12 that some people couldn't see that as intent as some of the
13 evidence overlaps to show he is not an inventor because I
14 can think of at least one document, there are facts within
15 there that someone could read as giving him intention, but
16 the document itself also says he was not making any
17 contribution to this. So to the extent it is the same
18 evidence, that is simply the evidence that we need to prove
19 our underlying inventorship claim.

20 THE COURT: I recall part of your case I think
21 that he had a financial interest or motivation to be named
22 as an inventor on I think as many patents as possible but at
23 least this one. Is that part of what you would try to prove
24 in front of a jury?

25 MR. RAWNSLEY: Well, Your Honor, the same

1 document in which that financial interest is stated also
2 attributes some of the elements that they're now saying
3 that Stevenson invented, it attributes that to Brendel. So
4 that is a document we need to rely on for our inventorship
5 defense and counterclaim.

6 THE COURT: Okay. Thank you. I'm going to let
7 the defendant proceed on this defense in front of the jury.
8 By this defense, I mean the improper joinder or misjoinder
9 defense.

10 Obviously, inequitable conduct per se is not
11 part of the jury trial. That will be tried separately in
12 front of the bench.

13 So the implications of that are if evidence is
14 solely relevant to the inequitable conduct, then it's not
15 to be presented in front of the jury.

16 The further implication is, of course, the
17 phrase "inequitable conduct" should not be uttered in front
18 of this jury, but the defendant has a separate misjoinder
19 defense. There are factual underpinnings to it. The
20 evidence is what it is. And it will be helpful, if not
21 necessary, for the jury to weigh in on those factual issues
22 that underlie it. So that is the ruling there.

23 There is next on my list, Greatbatch has some
24 concerns regarding certain Medtronic products and how the
25 defendants may want to use them as part of their invalidity

1 defenses. Let me hear briefly from the plaintiff.

2 I guess start by assuring me you understand this
3 to be opposed; correct?

4 MS. SMALLEY: Yes, I do.

5 THE COURT: Okay.

6 MS. SMALLEY: Basically, the Medtronic 122/123
7 reference was not selected by the defendant in its August
8 17th selection of references for claim 12. So we believe
9 that the invalidity defense on that is not properly before
10 the jury. And the derivation defense was not addressed in
11 invalidity contentions or expert report. So we believe that
12 that is not an issue for the jury either.

13 THE COURT: Okay. Let me hear from defendant.

14 MR. RAWNSLEY: Your Honor, defendants do intend
15 to proceed on the Medtronic 122/123 references as prior art.
16 It in fact was selected as one of the references in our
17 disclosure of prior art references and obviousness
18 combinations in NDT 122/123. It's right there.

19 THE COURT: Say it again.

20 MR. WHETZEL: It's Medtronic NDT 122/123.

21 THE COURT: I'm sorry. Where in the record is
22 that?

23 MR. RAWNSLEY: Well, this is in, the document
24 that we served on them pursuant to the Court's Order that we
25 identify our prior art references. I'd be happy to hand

1 this up to the Court.

2 THE COURT: Well, at least tell us the date so
3 plaintiff can.

4 MR. RAWNSLEY: Yes, this is pursuant to the
5 Court's Order. It is dated August 17th, 2015.

6 THE COURT: All right. I don't need to see it yet.

7 MR. RAWNSLEY: Okay. Medtronic references, this
8 particular Medtronic reference which is at issue here, we
9 believe it is relevant to several issues in the lawsuit.
10 First of all, the reference is, it is a letter sent from
11 Medtronic directly to one of the inventors of the '627 patent.

12 THE COURT: Let me stop you there. I understood
13 the argument just to be that you didn't timely select it
14 with respect to the claims you want to use it for now.

15 What is the argument? I'm looking at plaintiff
16 now. The August 17th, 2015 submission, does that not do it?

17 MS. SMALLEY: No. I mean it is selected as one
18 of the references, but it is not put against claim 12 or
19 even independent claim 11. So we say that for proceeding on
20 claim 12, they have not selected that reference.

21 THE COURT: Okay. Is that correct?

22 MR. RAWNSLEY: Your Honor, the Court's Order
23 required us to identify from the list of references that we
24 had previously been asserting to identify those references
25 that we were going to assert and as well to identify the

1 combinations that we intended to assert because that was
2 what the plaintiff was upset with at that point was that
3 they were arguing that we had not merely disclosed our
4 combinations.

5 It is correct it is not disclosed as a
6 combination, but that shouldn't prevent us from proceeding
7 for other purposes, anticipation or in itself for obviousness.

8 THE COURT: So what is it you propose to do, use
9 each of these for anticipation?

10 MR. RAWNSLEY: Anticipation or obviousness, as
11 necessary.

12 THE COURT: But not as a combination.

13 MR. RAWNSLEY: No, we do not plan and we haven't
14 told them that we intend to use it in combination. That is
15 not a position we have taken.

16 THE COURT: Did you disclose it as an anticipatory
17 reference or is it your view you didn't have to do it?

18 MR. RAWNSLEY: It was disclosed as an
19 anticipatory reference in Professor Webster's report. That
20 was a chart directed to it.

21 THE COURT: For this particular claim?

22 MR. RAWNSLEY: For claim 11, which forms part of
23 claim 12. That's correct.

24 THE COURT: Okay.

25 MS. SMALLEY: No.

1 THE COURT: Hold on.

2 But for claim 11 or claim 12?

3 MR. RAWNSLEY: For claim 11, Your Honor.

4 THE COURT: But we're going to trial on claim
5 12; right?

6 MR. RAWNSLEY: We believe that, but we believe
7 that in itself this renders obvious claim 12 because of the
8 distinction of what claim 12 adds to claim 11.

9 THE COURT: That may be true, but did you ever
10 disclose it as a reference with respect to claim 12?

11 MR. RAWNSLEY: We did not, Your Honor.

12 THE COURT: So on what basis should I excuse that?

13 MR. RAWNSLEY: We simply think that as what is
14 disclosed in the expert report provides a sufficient basis
15 to show that it invalidates claim 12.

16 THE COURT: All right. What about the
17 derivation point? Is that a different point?

18 MR. RAWNSLEY: That is a different point, Your
19 Honor. This is, Professor Stevenson has argued that he is
20 an inventor as to certain claims of the '627 patent. One of
21 those claims is claim 13. We must disprove that because he
22 is arguing he contributed it and that it is significant.

23 Professor Webster disclosed in his expert
24 report -- in his opening expert report, he said this cannot
25 be significant because there is this Medtronic 122/123

1 reference which was simply part of the state of the art.
2 This is a reference that was sent from Medtronic to one
3 of the named inventors on the '627 patent. So both of them
4 were aware of this when they received it. This was
5 addressed in his opening report. This was addressed in his
6 reply report. The author of the document was deposed.
7 Brendel was deposed on it. There has been full and fair
8 disclosure of that position.

9 THE COURT: All right. Thank you.

10 Let me hear again from plaintiff, if you have
11 anything you want to add.

12 MS. SMALLEY: Your Honor, I didn't understand from
13 the pretrial order that they're using this on inventorship.
14 The pretrial order just states that the claim is invalid due
15 to derivation for Medtronic 122 and 123. That is not -- I
16 mean that is a separate issue from inventorship.

17 THE COURT: Do we have any of the defendants'
18 response on this issue in the pretrial order?

19 MS. SMALLEY: I think they just said defendants
20 disagree.

21 THE COURT: All right. Well, I'm going to
22 need further assistance on this set of issues that we just
23 discussed. So before we break, we'll talk about what that
24 assistance should look like.

25 Next, AVX has a concern with witnesses being

1 recognized as -- expert witnesses being recognized as
2 experts. Who wants to address that?

3 MR. WHETZEL: Yes, Your Honor. Consistent with
4 the practice of at least some judges or former judges in
5 this court, it's been viewed as inappropriate to ask the
6 Court to recognize or essentially anoint a particular
7 witness as an expert for fear that that gives undue weight
8 to a witness's testimony. It would apply to both sides. I
9 think that may be particularly heightened here given the
10 earlier *Daubert* motion we filed that the Court has denied
11 permitting Professor Stevenson to testify in the form of an
12 expert.

13 THE COURT: So what would we do to, as a
14 gateway, allow someone to testify as an expert?

15 MR. WHETZEL: Your Honor, what other members of
16 the bench and this court have done is simply allowed counsel
17 to lay a foundation, to establish the expertise of the
18 witness as one normally would, and to then proceed into
19 questions in the form of expert opinions. If there is an
20 objection at that point in time, the Court rules on the
21 objection. Otherwise, we dispense with the procedure where
22 one lawyer or the other largely for show in front of the
23 jury says I ask the Court to recognize Mr. X as an expert.

24 THE COURT: All right.

25 MR. WHETZEL: That is our position.

1 THE COURT: Is this opposed?

2 MR. MULDOON: Yes, Your Honor. With respect
3 to Mr. Stevenson, this is an issue between Mr. Stevenson
4 who was disclosed and submitted reports as an expert, giving
5 expert testimony, versus Dr. Panlener who the Court has
6 already ruled is a fact witness but has specific technical
7 knowledge.

8 Professor Stevenson is one of the world's
9 renowned experts and has over 120 patents in this field. We
10 believe that the evidence that goes into that foundation for
11 his opinions is worthy for the jury to hear that he meets
12 the standards for giving expert opinions before them.

13 THE COURT: All right. I think both sides are
14 clearly reasonable here. But my standard practice at least
15 in recent years has been to have you, at the end of the
16 essentially voir dire of the expert, say "we hereby offer
17 expert so-and-so as an expert," and I ask if there is an
18 objection. And if there isn't, then I say "he or she is so
19 recognized." That is as much as I say.

20 I'm going to adhere to that general practice.
21 Of course, I will apply it equally to both sides' experts.
22 And I am be sure you will all not let me do otherwise. I
23 will be sure to instruct the jury carefully on what it means
24 to be an expert and how they are the final judges of the
25 credibility of all witnesses, including experts.

1 Next, AVX wants to somehow divide examinations
2 of witnesses between multiple attorneys, or maybe it is
3 Greatbatch. I forget.

4 MR. MULDOON: No objection either way. We kind
5 of both split the case up differently amongst our team, so
6 there will be a few witnesses that for each side there will
7 be multiple attorneys examining the witness.

8 THE COURT: Do you have in mind multiple
9 attorneys at the same time questioning the witness or just
10 at different points in the case?

11 MR. MULDOON: With respect to, for example,
12 Your Honor, Mr. Stevenson, who is an inventor of multiple
13 patents, I understand that the defendants have split that up
14 on a per patent basis.

15 Our team has split things up more on
16 infringement and invalidity issues. So, for example, if
17 there is, if Professor Webster is on the stand opining both
18 as the noninfringement and invalidity, one attorney would
19 handle the infringement questioning and then hand it over
20 for the invalidity type, just as the different attorneys
21 would examine Mr. Stevenson on different patents.

22 THE COURT: And you have no objection to that?

23 MR. MULDOON: No, Your Honor.

24 THE COURT: And is that all consistent with
25 defendants' understanding as well?

1 MR. WHETZEL: It is, Your Honor.

2 THE COURT: All right. Well, I have seen that
3 done badly before in a way that confuses the jury and
4 arguably is abusive to the witness. I don't want that to
5 happen. Do your best to make it clean and sort of I guess
6 segregable would be the word.

7 It would be a shame if a series of three or
8 four lawyers all kept popping up and trying to impeach the
9 witness repeatedly on perhaps the same points just because
10 he or she talked about three or four patents, but I will
11 trust that you will all handle that responsibly.

12 In terms of closing the courtroom, evidently
13 there is no dispute that that is going to be requested at
14 least some times. My procedure there is you really need to
15 give me some notice so I can make sure, among other things,
16 I have Court Security Officer around in case somebody needs
17 to be asked to leave and if we need to lock the doors.

18 Provide notice to one another and provide notice
19 to me. And keep the requested portion of the trial, the
20 portion that you request be closed to the public, keep it
21 to the bare minimum necessary. Try your best to segregate
22 whatever portion of the examination is going to be kept
23 confidential from the public so we don't have to repeatedly
24 open and close the courtroom.

25 As long as you comply with that, we shouldn't

1 have a problem.

2 Juror notebooks. I only wanted to point out the
3 burden is on all of you to prepare those. It looked as if
4 you are in agreement as to giving juror notebooks and what
5 will be in them.

6 I guess my only other question there was once
7 or twice, I've had photos of the witnesses put in the juror
8 notebooks. Is that a something you all considered or would
9 be amenable to?

10 MR. MULDOON: I have not considered it, Your
11 Honor, and we can discuss with others.

12 THE COURT: Okay.

13 MR. WHETZEL: I was going to say we haven't
14 discussed it, but we will discuss that, Your Honor.

15 THE COURT: I order you to discuss it. If
16 you reach an agreement, then proceed according to your
17 agreement.

18 We still have a dispute regarding the '077
19 patent and how it should be discussed. I am really to
20 address that now.

21 Having reviewed the letter, I agree with AVX on
22 this point. Therefore -- and I don't think I have an order
23 to sign, so if that is correct, and I direct AVX to submit
24 an order to which Greatbatch will agree as to form which
25 will accomplish what AVX proposed in the letter regarding

1 the '077 patent which is essentially the infringement claims
2 are dismissed, the affirmative defenses and counterclaims
3 are dismissed, but AVX may maintain its ability to claim it
4 as a prevailing party at least for purposes of Section 285
5 and the right to seek attorney fees and costs under any
6 applicable statute or law.

7 And whether or not something further needs to be
8 proven in order for AVX to be deemed a prevailing party is
9 an issue we'll address later, if we have to.

10 Are there any questions about any of that,
11 plaintiff?

12 MR. MULDOON: No, Your Honor.

13 THE COURT: Defendants?

14 MR. WHETZEL: No, Your Honor.

15 THE COURT: In our remaining time, let's first
16 talk about this trial and how long it is going to be. You
17 all had asked for 30 hours a side. I don't believe I have
18 ever had a trial more than 24 hours a side, and my strong
19 sense is this case can be tried fairly by both sides in no
20 more than 24 hours per side, particularly in light of some
21 of the rulings I have made.

22 Secondary considerations is not in the case.
23 Evidence regarding the IPR is not in the case. We don't
24 yet know whether the '627 patent particularly infringement
25 will be in the case. You all are going to meet and confer

1 about all of that. If anybody appeals feels particularly
2 prejudiced by a limit of 24 hours, I will hear that now.

3 Plaintiff?

4 MR. MULDOON: That's fine, Your Honor.

5 THE COURT: Okay. Defendants?

6 MR. WHETZEL: We'll abide by that, Your Honor.

7 THE COURT: All right. Well, then I do hereby
8 allocate a maximum of 24 hours per side.

9 I will get an order out that tells you I do
10 have certain conflicts. Some of the days are going to be a
11 little shorter than our normal. The normal is that counsel
12 is here from 8:30. The jury is here from 9:00 to 4:30. I
13 know on the 12th and the 13th, the first Tuesday and
14 Wednesday, I need to end at either 3:00 or 4:00 o'clock.
15 I'll clarify that and put that in an order for you.

16 There is no trial on Monday the 18th. That is a
17 federal holiday. And Thursday the 21st, I have to end by
18 3:30.

19 So, again, I'll put that all together for you in
20 an order.

21 We aim for approximately an hour of breaks a
22 day, a 15 minute break in the morning, 15 minute break in
23 the afternoon, roughly a half hour for lunch because we
24 provide lunch to the jury after the first day.

25 In terms of counting time, I think you all have an

1 understanding of that. Basically, other than jury selection
2 and me reading instructions to the jury and whatever argument
3 we have on the jury instructions during the trial, other than
4 that, if I'm in the courtroom, somebody is being charged for
5 the time.

6 Are there any questions about time?

7 MR. MULDOON: No, Your Honor.

8 THE COURT: No.

9 MR. CAHILL: (Shaking head no.)

10 THE COURT: From defendants?

11 MR. WHETZEL: No, Your Honor.

12 THE COURT: Turning to the remainder of the
13 pretrial order. If the parties did not identify a dispute
14 in the pretrial order and I don't address it, then what you
15 have proposed is acceptable and hereby adopted.

16 I don't see anything further we need to talk
17 about now in terms of what the bench trial issues will be
18 or any issues as to what the legal issues and fact issues
19 to be tried are going to be.

20 Are there any questions on any of that?

21 MR. WHETZEL: No, Your Honor.

22 MR. MULDOON: There are some issues, Your Honor,
23 with respect to further modifying each party's proposed
24 final jury instructions in light of many of the rulings that
25 have been made today.

1 THE COURT: Right. I appreciate that. Thank you.

2 So I do want a new version of the final jury
3 instructions as well as the final verdict sheet in light of
4 what I have ruled today. And it needs to await whatever you
5 all decide with respect to the '627 as well.

6 I don't need the next version of the final jury
7 instructions and verdict sheet until we start the trial. So
8 in the absence of some agreement between the parties to the
9 contrary, let's say those are due by Tuesday, the first
10 Tuesday of trial, at the end of the day.

11 Now, to the extent you want to modify the
12 preliminary instructions as well, that, I do need in advance
13 of trial because I need to docket that for you before we
14 start jury selection. So let's make that due by the
15 Thursday before trial begins.

16 Are there any questions about any of that?

17 MR. MULDOON: (Shaking head no.)

18 THE COURT: Are there questions about that?

19 MR. CAHILL: (Shaking head no.)

20 THE COURT: No. Is there something else you
21 want to raise?

22 MR. MULDOON: Yes, Your Honor. It appears we
23 have, in light of some updated sales data, we need to amend
24 our exhibit list, and there are two corrections as well.

25 MS. SMALLEY: Right.

1 THE COURT: Is that something you have discussed
2 with the defendants?

3 MS. SMALLEY: Yes, I brought it up.

4 MR. RAWNSLEY: It was raised briefly with us
5 right before we walked in, but we'll discuss it with them.

6 THE COURT: I trust there won't be an issue with
7 that.

8 In terms of, now coming to witnesses, there were
9 some disputes about witnesses, whether Mr. Stevenson should
10 be sequestered and objections regarding an Aaron Cook and
11 Neal Springarm and something about Professor Pilgrim's claim
12 construction declaration.

13 Do plaintiffs want to be heard on any of these
14 issues?

15 MR. MULDOON: Yes, Your Honor.

16 THE COURT: Okay.

17 MR. MULDOON: The two individuals on the exhibit
18 list are the laboratory individuals who prepared testing
19 that were relied upon by Dr. Pilgrim with respect to his
20 reports.

21 While AVX does not object to the authenticity
22 of Mr. Springarm's photographs, I understand that they still
23 object to the admissibility of them and, therefore, if there
24 is going to be a dispute over these photographs, the
25 individual who, if you recall, we had to pick somebody in

1 Los Angeles where Mr. Rawnsley brought the samples to
2 Mr. Springarm's office, which wasn't done until the very end
3 of discovery, additionally, the other witness was from IMR
4 Test Labs, in Ithaca, New York who prepared the photographs
5 and images of three samples that we did receive.

6 THE COURT: Okay. And why should Mr. Stevenson
7 be treated any differently for sequestering purposes?

8 MR. MULDOON: Well, Your Honor, what I would
9 propose with respect to Mr. Stevenson is since his expert
10 opinion deals with invalidity issues is that he be sequestered
11 during the infringement case, but once AVX moves into its
12 invalidity case that he be allowed to hear the testimony of
13 AVX's invalidity witnesses so that he can consider those in
14 rendering his opinions.

15 THE COURT: Okay. Thank you. Let me hear from
16 defendants.

17 MR. WHETZEL: Your Honor, as to Professor
18 Stevenson, the delineation that Mr. Muldoon proposed doesn't
19 quite get to the problem. Professor Stevenson's expert
20 opinions, subject to voir dire later to see if they're in
21 fact expert opinions, relate to very limited and discrete
22 subjects. What they don't relate to is the basic facts and
23 circumstances of the invention story or invention history
24 here.

25 We think that he is a pure fact witness on

1 those issues as to his collaboration and the corroboration,
2 who did what during the course of the invention, and at a
3 minimum he should be excluded during the fact testimony of
4 other witnesses who are speaking to those issues, primarily
5 his primary coinventor.

6 THE COURT: All right. These other two
7 witnesses?

8 MR. WHETZEL: The witnesses that immediately
9 come to mind, Your Honor, would be his purported coinventor.

10 THE COURT: No, I meant to manufacture on to the
11 other issue.

12 MR. WHETZEL: Oh, I'm sorry. Yes. That would
13 be Mr. Cahill.

14 THE COURT: Okay.

15 MR. CAHILL: Yes, Your Honor. We object to
16 these two witnesses providing any substantive testimony
17 because they have never been disclosed and we have never
18 been able to take their deposition.

19 THE COURT: Do you object to them coming in to
20 authenticate these photographs?

21 MR. CAHILL: We agreed to waive authentication
22 objections. We wouldn't agree to waive other evidentiary
23 objections.

24 THE COURT: All right. Where does that leave
25 us? Do you need them for something more than authentication?

1 MR. MULDOON: Well, Your Honor, with respect,
2 authentication would involve the equipment and whether or
3 not there were any difficulties in focusing the camera on
4 the images that the defendants' counsel says are worthless
5 and not suitable for expert, subject of expert testimony.
6 So we would need him to, authentication is somewhat broader
7 than, yes, I took the pictures.

8 THE COURT: Okay. Thank you. So I can give you
9 a partial ruling on these, and I'll need to know whether
10 this resolves the issue or not after you have had a chance
11 to confer further.

12 With respect to Mr. Stevenson, I agree
13 conceptually he should be sequestered on those issues for
14 which he is going to be a fact witness and not sequestered
15 on those issues for which he is an expert witness.
16 Hopefully, I didn't get that backwards. But how we're going
17 to actually do that, I need you all to meet and confer on,
18 and if there are specific portions of the trial that you are
19 not in agreement on, you will have to bring those disputes
20 to my attention and I'll resolve them.

21 With respect to these two lab technician
22 witnesses, I will permit them to testify at least with
23 respect to authentication, and I may permit them to testify
24 beyond that as well. But if you all can't resolve that,
25 then I'm going to need to have something in writing to show

1 me exactly what was disclosed when and what the topics are
2 beyond pure authentication that the plaintiff wants them to
3 testify on.

4 We only have a few minutes left. Why don't
5 I turn to you all now and see if there are things you are
6 particularly concerned with that you want to make sure
7 we address before we part for today, first from the
8 plaintiff.

9 MR. MULDOON: There are still some disputes
10 about the jury verdict sheet and their jury questionnaire.

11 THE COURT: Thank you. So the jury
12 questionnaire, as I understand it, you oppose using a
13 questionnaire; is that correct?

14 MR. MULDOON: Your Honor, the last probably
15 six to eight questions are completely objectionable and
16 trying to taint the jury. The first half of the form is
17 duplicative of the form information already used and the
18 middle few questions are duplicative of the Court's voir
19 dire.

20 THE COURT: All right. I'm not going to do the
21 jury questionnaire. I have done it in a couple of cases but
22 every time I have done it, it has been without objection.
23 To the extent there are, my understanding is that plaintiff
24 objects to using it at all. It also came in fairly late.
25 I'm told it would have to get into the mail today in light

1 of the holidays. I think that my voir dire process and
2 the follow-up I allow from counsel will adequately protect
3 everybody's rights with respect to jury selection.

4 In terms of jury instructions and verdict sheet,
5 as I have already indicated I think, you will be getting me
6 a new version by the Tuesday of trial and I'll let you know
7 some time during trial when we'll have argument on any
8 remaining disputes.

9 Yes.

10 MR. MULDOON: Your Honor, it's our belief that
11 there will be numerous exhibits that will be presented that
12 are technically -- there are engineering drawings, technical
13 documents that disclose proprietary information regarding
14 products. We would ask that those be filed under seal with
15 respect to those exhibits that have that level of information.

16 THE COURT: Is there any objection to that concept?

17 MR. WHETZEL: Your Honor, a lot of this
18 technology is very old, and I'm not sure that it meets
19 the Third Circuit standard for sealing evidence that is
20 presented at trial.

21 THE COURT: All right. Well, we'll deal with
22 those objections. If there is an objection to a particular
23 exhibit that the plaintiff or defendants for that matter
24 wants to be sealed, that is something that you will talk
25 about in the process of disclosing exhibits to one another

1 and make the objection known to me in the morning when the
2 witness is going to testify, and we'll resolve it in that
3 context.

4 Are there other issues from the plaintiff?

5 MR. MULDOON: Nothing further, Your Honor.

6 THE COURT: All right. How about from the
7 defendants?

8 MR. WHETZEL: Yes, Your Honor. The only
9 other issue, and it is admittedly a fairly minor one, is
10 the parties were not in agreement on the timing of the
11 disclosure and submission of deposition designations. I
12 apologize to take the Court's time but it's not clear what
13 the rules are going to be.

14 THE COURT: I saw that. Actually, that was the
15 next thing I wanted to make sure to touch on so you know
16 what to do.

17 I'm going to go with Greatbatch's proposal there
18 which is a little bit more time, requires you all to start
19 earlier but I think will help me do my best to get you
20 rulings on time so that you can be prepared to play or read
21 whatever you are permitted to play or read.

22 Is there anything else from defendants?

23 MR. WHETZEL: Your Honor, the only general
24 question is that these time frames for advanced disclosures,
25 hopefully we can work this out among counsel, oftentimes

1 don't work as well when we get to rebuttal cases, and
2 presumably there will be some spirit of compromise and
3 understanding that in rebuttal cases, we can't necessarily
4 predict a rebuttal case three or four days in advance of
5 the completion of the prior case.

6 THE COURT: Right. In my experience, there has
7 been reasonable accommodation on those issues. And I trust --

8 MR. MULDOON: We will do our best to be
9 reasonable, Your Honor.

10 THE COURT: All right. If someone is not
11 reasonable, I expect I will hear about it.

12 In terms of the further assistance that I need
13 from you, by my recollection here, I said I need some, I
14 need to hear back from you what your thoughts are on the
15 '627 infringement issue.

16 I also set aside the question about the
17 Medtronic prior art and how, if at all, that is going to be
18 used, and then the recent questions that just came up about
19 Mr. Stevenson and the lab technician witnesses.

20 Let's proceed this way. I'd like, as I have
21 indicated before, a joint letter tomorrow. In that letter,
22 tell me whether you have worked out any of those disputes,
23 and if you haven't, tell me the timing with which you
24 propose to get me whatever short written submissions that
25 you want me to have in order to resolve those disputes.

1 Are there any questions about that?

2 MR. MULDOON: No, Your Honor.

3 MR. WHETZEL: No, Your Honor.

4 THE COURT: I guess that covers it all. Thank
5 you all very much. Happy holidays and safe travels. We
6 will be in recess.

7 (Pretrial conference ends at 2:02 p.m.)

8

9 I hereby certify the foregoing is a true and accurate
10 transcript from my stenographic notes in the proceeding.

10

11 /s/ Brian P. Gaffigan
12 Official Court Reporter
13 U.S. District Court
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